TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1906.

No. 150.

RICHARD BONG, PLAINTIFF IN ERROR,

vs.

THE ALFRED S. CAMPBELL ART COMPANY.

IN ERROR TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

FILED JULY 25, 1907.

(20,816.)

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a United States Circuit Court of Appeals for the Second Circuit.

RICHARD BONG, Plaintiff in Error (Plaintiff Below),
vs.
THE ALFRED S. CAMPBELL ART COMPANY, Defendant in Error (Defendant Below).

Transcript of Record.

Error to the Circuit Court of the United States for the Southern District of New York.

[Stamped:] United States circuit court of appeals, second circuit. Filed Jan. 28, 1907. William Parkin, clerk.

1 *Writ of Error.*

UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Judges of the Circuit Court of the United States for the Southern District of New York:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Circuit Court, before you, or some of you, between Richard Bong, plaintiff, and The Alfred S. Campbell Art Company, defendant, a manifest error hath happened, to the great damage of the said Richard Bong, plaintiff, as is said and appears by its complaint. We, being willing that such error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Judges of the United States Circuit Court of Appeals for the Second Circuit, at the United States Court House and Post Office Building, in the City of New York, together with this writ, so that you have the same at the said place, before the Justices aforesaid, on the 8th day of February, 1907, that the record and proceedings aforesaid being inspected, the said Judges of the United States Circuit Court of Appeals for the Second Circuit may cause further to be done therein to correct that error, what of right and according to the law and custom of the United States ought to be done.

Witness, the Honorable Melville W. Fuller, Chief Justice
2 of the United States, this 9th day of January, in the year of our Lord one thousand nine hundred and seven, and of the Independence of the United States the one hundred and thirty-first.

[L. S.] JOHN A. SHIELDS,
Clerk of the United States Circuit Court for the Southern District of New York, in the Second Circuit.

The foregoing writ is hereby allowed to operate as a supersedeas.

C. M. HOUGH,
U. S. District Judge.

January 9th, 1907.

To the Honorable the Judges of the Circuit Court of Appeals for the Second Circuit:

Richard Bong, plaintiff in a certain action entitled Richard Bong, Plaintiff, against The Alfred S. Campbell Art Company, Defendant, pending in the United States Circuit Court for the Southern District of New York, in which judgment was entered dismissing the complaint with costs on December 20, 1906, hereby applies for allowance of the accompanying writ of error.

Dated New York, January 8, 1907.

MAX J. KOHLER,
Attorney for Plaintiff in Error,
42 *Broadway, New York.*

UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, John A. Shields, Clerk of the Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit, by virtue of the foregoing writ of error, and in
3 obedience thereto, do hereby certify that the following pages, numbered from four to twenty-five, inclusive, contain a true and complete transcript of the record and proceedings had in said court in the cause of Richard Bong, plaintiff in error, *vs.* The Alfred S. Campbell Art Company, defendant in error, as the same remain of record and on file in said office.

In testimony whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 18th day of January, in the year of our Lord one thousand nine hundred and seven, and of the Independence of the United States the one hundred and thirty-first.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

United States Circuit Court, Southern District of New York.

RICHARD BONG
against
THE ALFRED S. CAMPBELL ART COMPANY.

Action for penalty of $10,000 under Rev. Statutes U. S. 4965 as amended, one half to the use of the United States; also forfeiture of plates, copies, &c.

To the Above Named Defendant:

You are hereby summoned to answer the complaint in this action, and to serve a copy of your answer on the plaintiff's attorney within twenty days after the service of this summons, exclusive of

the day of service; and in case of your failure to appear, or
4 answer, judgment will be taken against you by default for the relief demanded in the complaint.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, at the Borough of Manhattan, in the City of New York, this 8th day of June, in the year 1905.

[L. S.] JOHN A. SHIELDS, *Clerk.*

MAX J. KOHLER,
Plaintiff's Attorney,

Office and Post Office address, 42 Broadway, Borough of Manhattan, New York City.

Circuit Court of the United States for the Southern District of New York.

RICHARD BONG, Plaintiff,
against
THE ALFRED S. CAMPBELL ART COMPANY, Defendant.

The plaintiff above named, suing in this behalf for the benefit of himself and one-half for the use of the United States, alleges:

I. That he is and at all times herein mentioned was a citizen and subject of the German Empire and resident of the City of Berlin in said Empire, said State and nation being one which permits to citizens of the United States of America the benefit of copy-
5 right on substantially the same basis as its own citizens and which is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement, the existence of which conditions has been determined by the President of the United States by proclamation duly made (Statutes at Large, Vol. 27th, pp. 1021-22).

II. That at all the times mentioned herein the defendant was a citizen and resident of the State of New Jersey, being a corporation duly organized and incorporated under the laws of the State of New Jersey, and having a place of business within the State and Southern District of New York, in which State and District it does business, and has filed a statutory certificate under New York law.

III. That in or about the year 1899 one Daniel Hernandez painted and designed a certain beautiful and artistic painting of which he is the author, inventor and designer, called "Dolce far niente," said Daniel Hernandez then and ever since being a citizen and subject of Spain, which state and nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens, as has been determined by proclamation of the President of the United States duly made and published (29 Statutes at Large, p. 871), and prior to November 8, 1902, plaintiff became the lawful and sole proprietor of said painting by due assignment, pursuant to law.

IV. That before publication of said painting in this or any foreign country, to wit, on or about November 8, 1902, plaintiff delivered at the office of the Librarian of Congress a description of said painting, for which he desired a copyright, and on said day and not later than the day of publication thereof in this or any
6 foreign country, delivered at the office of the Librarian of Congress at Washington, District of Columbia, a photograph of said painting, and thereupon the Librarian of Congress did record forthwith the name of such painting in a book kept for the purpose, and did also record the facts aforesaid, and that plaintiff claimed the right to said painting, as proprietor, in conformity with the laws of the United States respecting copyrights.

V. That before publication of said painting or any copy thereof, plaintiff inscribed and has kept inscribed upon a visible portion of said painting the words "Copyright 1902 by Rich. Bong," as also upon every copy thereof, issued by him or by his or any lawful authority, and the same is and ever since has been, inscribed upon a visible portion of said picture.

VI. That by reason of the premises, plaintiff became and was and is entitled, for the term of twenty-eight years from November 8, 1902, to the sole liberty of printing, reprinting, publishing, copying, executing, finishing and vending said picture "Dolce far niente."

VII. That defendant, after the recording of the description of the said painting and within two years prior to the commencement of this action did unlawfully copy, print, engrave, etch, work and publish copies of said painting, contrary to the provisions of the statutes of the United States (particularly Section 4965 of the Revised Statutes of the United States as amended) and without the consent of the proprietor of the copyright first obtained, in writing or otherwise, signed in the presence of two or more witnesses, and knowing the same to be so printed and published, did sell and expose to sale copies of said painting, under the name and description "Sunbeam" by Hernandez, No. 3104, colored gravures, at listed price of $1.50 for pictures 6½ inches by 11, and $6 for pic-
7 tures 12 by 20 inches; that said defendant has sold, exposed for sale and has in its possession, as plaintiff avers on information and belief, upwards of one thousand copies of said painting, thus unlawfully copied, engraved, etched, worked, printed and published, within the Southern District of New York.

VIII. That said work, copy, print and publication by defendant of plaintiff's copyrighted painting was done without the knowledge or consent of the plaintiff and against his will, and to his great injury and in violation of his exclusive right to print, reprint, publish, copy and sell said painting "Dolce far niente" as secured to him by the laws of the United States on the subject of copyright.

IX. That by reason of the premises and under the provisions of Section 4965 of the Revised Statutes of the United States, as amended by the Act of March 3, 1895, the defendant has forfeited to plaintiff all the plates on which said painting is copied, and every sheet thereof, either copied or printed, and ten dollars for every copy of the same in its possession and by it sold and exposed for sale, not

more however than ten thousand ($10,000) whereof half shall go to the plaintiff and the other half to the use of the United States.

X. Wherefore plaintiff demands judgment against defendant as follows:

First. Judgment of forfeiture by defendant to plaintiff of all the plates on which said painting shall be copied.

Second. Judgment of forfeiture by defendant to plaintiff of every sheet on which said painting is copied or printed.

8 Third. Judgment of forfeiture by defendant to plaintiff of ten ($10) dollars for every copy of plaintiff's painting "Dolce far niente," by it called "Sunbeam," in possession of defendant or by it sold or exposed for sale; such judgment not to exceed in the aggregate, however, ten thousand dollars, whereof one-half is to be paid to plaintiff and one-half to the use of the United States.

Fourth. Judgment in favor of plaintiff against defendant for his costs and disbursements in this suit.

MAX J. KOHLER,
Attorney for Plaintiff.

Office and Post Office address, 42 Broadway, New York.

CITY AND COUNTY OF NEW YORK,
Southern District of New York, ss:

Max J. Kohler, being duly sworn, deposes and says: That he is the attorney for plaintiff herein; that plaintiff is a citizen and resident of the Empire of Germany, and resides in the City of Berlin, in said Empire, and is not within the County or State of New York, nor within this country, nor within the county where deponent resides, nor within the county where deponent has his office; that he has read the foregoing complaint and knows the contents thereof, and that all the allegations therein are true, as he is duly informed and believes; that the sources of his information and the grounds of his belief are more fully set forth in an accompanying affidavit made by deponent, verified this day, to which reference is made.

MAX J. KOHLER.

Sworn to before me this 8th day of June, 1905.

[L. S.] EDW. J. KOHLER,
Notary Public, New York County.

9 United States Circuit Court, Southern District of New York.

RICHARD BONG, Plaintiff,
against
THE ALFRED S. CAMPBELL ART CO., Defendant.

Notice of Appearance.

SIR: Please to take notice that the defendant, The Alfred S. Campbell Art Co., appears in this action, and that we are retained as attorneys for defendant therein, and demand that a copy of the

complaint and all papers in this action be served on us at our office, No. 309 Broadway, in the City of New York.

Dated, fifth day of August, 1905.

Yours, &c.,

BAGGOTT & RYALL,
Attorneys for Defendant.
309 *Broadway, New York City, N. Y.*

To Max J. Kohler, Esq., Plaintiff's Attorney, No. 42 Broadway, New York City, N. Y.

(Endorsed:) U. S. Circuit Court.—Richard Bong, Plaintiff, against The Alfred S. Campbell Art Co., Defendant.—Notice of Appearance.—Baggott & Ryall, Attorneys for Defendant, 309 Broadway, New York City, N. Y.—Due service of a notice of which the within is a copy admitted this 7th day of August, 1905. Max J. Kohler, Plaintiff's Attorney.—U. S. Circuit Court, Southern District New York.—Filed Aug. 7, 1905.—John A. Shields, Clerk.

10 Circuit Court of the United States for the Southern District of New York.

RICHARD BONG, Plaintiff,
against
THE ALFRED S. CAMPBELL ART CO., Defendant.

The defendant above named by Baggott & Ryall, its attorneys, answering the complaint herein, respectfully shows to this Court:

First. It denies any knowledge or information sufficient to form a belief as to the matters set forth and alleged in paragraph numbered "I." of the said complaint.

Second. It admits the allegations contained in paragraph number "II." of the said complaint.

Third. It denies that it has any knowledge or information sufficient to form a belief as to the matters set forth and alleged in paragraph numbered "III." of the said complaint.

Fourth. Upon information and belief, the defendant denies the allegations contained in paragraphs numbered "IV.," "V.," "VI." "VII." and "VIII." of said complaint and each and every part thereof.

11 Wherefore, the defendant demands judgment that the complaint herein be dismissed, together with the costs and disbursements of this action.

BAGGOTT & RYALL,
Attorneys for Defendant, 309 Broadway,
Borough of Manhattan, New York City, N. Y.

COUNTY OF NEW YORK, *ss:*

George Ryall, being duly sworn, says: That he is one of the attorneys for the defendant named in the foregoing answer, that he has read the said answer and knows the contents thereof, and that the same is true to his knowledge except as to the matters which are

therein stated to be alleged on information and belief, and that as to those matters he believes it to be true.

That the reason this verification is not made by the defendant is because the defendant is a foreign corporation and none of its officers are within the County of New York, where deponent has his office and capable of making this affidavit. That the grounds of deponent's information and the source of his belief as to the matters not stated upon knowledge are the claim in suit and statements made to him by Arthur F. Rice, vice-president of the defendant company.

GEO. RYALL.

Sworn to before me this 23d day of August, 1905.

HARRY J. SCHULTZ,
Notary Public, N. Y. County.

(Endorsed:) Circuit Court of the United States for the Southern District of New York.—Richard Bong, Plaintiff, agst. The Alfred S. Campbell Art Co., Defendant.—Answer.—Baggott & Ryall, Attorneys for Defendant, 309 Broadway, Borough of Manhattan, New York City.—U. S. Circuit Court, Southern District New York.—Filed Aug. 23, 1905.—John A. Shields, Clerk.

12 At a Stated Term of the Circuit Court of the United States of America, for the Southern District of New York, in the Second Circuit, held at the United States Court Rooms, in the Borough of Manhattan, in the City of New York, on Wednesday, the 12th day of December, in the year of our Lord one thousand nine hundred and six.

Present: The Honorable Charles M. Hough, Judge.

RICHARD BONG
vs.
THE ALFRED S. CAMPBELL ART CO.

Now comes the plaintiff by Max J. Kohler, Esq., his attorney, and moves the trial of this cause. Likewise comes the defendant by George Ryall, Esq., and Albert K. Newman, Esq., its attorneys. Thereupon a jury is impaneled and the cause proceeds to trial.

Thereafter, on Thursday, the 13th day of December, 1906, after hearing the arguments of counsel for the respective parties, the jury, by direction of the Court, find a verdict in favor of the defendant.

Stay of 60 days after entry of judgment granted plaintiff within which to make and serve a case, with leave to turn same into a bill of exceptions.

The Court grants leave to the plaintiff to move to amend the complaint within 10 days, upon notice.

An extract from the minutes.

JOHN A. SHIELDS, *Clerk.*

13 Circuit Court of the United States for the Southern District of New York.

RICHARD BONG, Plaintiff,
against
THE ALFRED S. CAMPBELL ART COMPANY, Defendant.

The issues in this action having been duly brought on for trial before the Honorable Charles M. Hough, one of the Judges of this Court, and a jury, at a Trial Term of this Court, held in the Post Office Building, in the Borough of Manhattan, City of New York, on the 12th day of December, 1906, and the plaintiff having presented his case and having made certain admissions upon the opening of said case, and the Court having directed the jury to bring in a verdict for the defendant, and the jury having found a verdict in favor of the defendant, and the costs having been taxed herein at the sum of $107.25,

Now, upon motion of Messrs. Baggott & Ryall, attorneys for defendant, it is

Ordered and adjudged, that the defendant, The Alfred S. Campbell Art Company, have judgment against the plaintiff, Richard Bong, dismissing the complaint herein and for the sum of one hundred seven and 25/100 dollars ($107.25), and that the said defendant have execution therefor against the plaintiff.

Dated New York, December 20, 1906.

JOHN A. SHIELDS, *Clerk.*

(Endorsed:) Circuit Court of the United States, Southern District of New York.—Richard Bong, Plaintiff, against The Alfred
14 S. Campbell Art Co., Defendant.—Judgment.—Baggott & Ryall, Attorneys for Defendant, 309 Broadway, Borough of Manhattan, New York.—U. S. Circuit Court, Southern District New York.—Filed Dec. 20, 1906.—John A. Shields, Clerk.

United States Circuit Court, Southern District of New York.

RICHARD BONG, Plaintiff,
against
THE ALFRED S. CAMPBELL ART COMPANY, Defendant.

Before Hon. Charles M. Hough, D. J., and a Jury.

Plaintiff's Bill of Exceptions.

On the 12th day of December, 1906, the issues in this cause came on for trial.

Appearances.

Max J. Kohler, Attorney for Plaintiff.

Baggott & Ryall (George Ryall and Albert K. Newman, of Counsel), for Defendant.

A jury was called, examined, accepted and sworn. Defendant moved to dismiss the complaint on the grounds that it did not state

facts sufficient to constitute a cause of action, that there was a
15 misjoinder of causes of action in one count and one complaint, a cause of action in the nature of replevin being joined with a cause of action for penalties, and because the United States were not parties to the suit, which motions were denied, with exceptions to defendant. Defendant's motion that plaintiff elect between causes of action, next made, was also denied, under exception, with leave to renew.

Mr. Kohler opened the case for the plaintiff, his opening not being reduced to writing, but in the same he stated that Mr. Bong was never the owner of the physical painting.

By consent of counsel on both sides, the Court examined correct translations of writings, concerning the painting in suit, executed by said Hernandez, and delivered by him to plaintiff on or about the dates therein specified, proved on commissions, issued for taking the testimony of Bong and Hernandez, at Berlin and Paris respectively, and reading as follows:

"The undersigned hereby authorizes Mr. Richard Bong, Berlin, W. 57 Potsdamer Street 88, and conveys to him the right to enter his painting 'Sweetly Dreaming' for copyright protection in America, viz., in the Copyright Register in Washington, to enter the same in his own name as proprietor, as well as to take any steps in his own name necessary for the securing and protection of said right.

Paris, June 1, 1902.

(Signed) DANIEL HERNANDEZ."

"I, the undersigned, D. Hernandez, artist, painter, living at 235 Fauborg St. Honore declare by these presents to cede to Messrs. Bong & Co., the exclusive right of reproduction, in colors and in all kinds, and also the exclusive right of engraving, etching, lithography in black and in colors, in consideration of the sum of 500 francs,
16 which I have this day received, and for which I hereby give receipt."

Paris, July 7, 1902.

Received payment,

DANIEL HERNANDEZ.

Revenue Stamp Marked cancelled July 7, 1902. D. H.

"P. S.—It is well understood that the right of photography and reproduction by all photographic monochrome processes is not herein included."

Counsel for plaintiff stated that he would offer no evidence to establish the citizenship of Daniel Hernandez, and would not controvert the statement made on behalf of the defense, that said Hernandez is and always had been a citizen of Peru.

Mr. NEWMAN: Now, your Honor, it was stated by the plaintiff's counsel in his opening that he should offer no evidence in regard to the citizenship of the painter of this picture. As a matter of fact Hernandez was a Peruvian, and not entitled to any copyright in this country; I move for direction of a verdict in favor of defendant on

this concession in plaintiff's opening that he will not attempt to prove that Hernandez is or was a citizen of any country as to which the President has issued any proclamation under Section 13 of the Act of March 3d, 1891 (1 Sup. Rev. St., p. 954).

Argument by counsel followed.

DECEMBER 13, 1906.

The COURT: "Mr. Kohler, it would be wrong for me to put all parties to the expense of time and money incident to trying out a large number of other issues when unless you are right on this particular proposition your whole case must fail, and I think that it is in the interest of justice to put on you, the plaintiff in a penalty suit, the burden of testing this question in the Appellate Court.

Mr. Kohler asks leave to proceed with the trial.

17 The COURT: "I recognize the fact that this is a question to come up in the future, but a penalty is a very noxious thing, and it is right to put the burden of testing this question of law on you. I do not think you are right. You may be. I decline to hear any further argument.

By the opening statement of counsel for the plaintiff it is shown that he intends to offer no evidence to substantiate the assertion of the complaint that the artist who painted the original picture, the reproduction of which is the origin of this controversy, is a subject of the King of Spain. He asserts his intention of standing upon the proposition that the citizenship of the artist is of no moment, and the case must therefore be decided as if Senor Hernandez were a citizen of a country not within the terms of the President's proclamation made pursuant to the International Copyright Act. Is that fair, Mr. Kohler?

Mr. KOHLER: It is absolutely fair, your Honor.

The COURT: It may be deemed for the purposes of argument that the plaintiff in this case, Richard Bong, is a subject of the Empire of Germany, and Germany is a country within the President's proclamation under the copyright statute.

It may well be within the power of Congress to grant to all aliens the privilege of copyright; but the present statutes do not in terms give that right to aliens other than those who are citizens or subjects of countries extending similar bounty to Americans.

The claim, therefore, that the citizen of a country not within our copyright acts can assign the right of reproduction to one who can obtain that privilege must be tested by the general rules of law as applied to the interpretation of copyright acts in countries governed by systems of law of English origin.

If Senor Hernandez could not himself obtain copyright in the United States—and I think it clear that he could not unless he were a citizen of a country within the President's proclamation—and could yet directly or indirectly (short of selling or giving away his picture before publication) confer upon another what he had
18 not himself, then I think the present International Copyright Act an idle form; inasmuch as any country may refuse to

American citizens all right of protection in literary or artistic productions, while their own citizens can always by a colorable assignment to the subject of a more generous sovereign, obtain the protection of American law. I think this unfair and within neither the letter nor the spirit of the present statute.

I am the more willing to arrive at this conclusion because it has been held in many cases, in England especially, and in actions that were brought under copyright acts, that if there be any reasonable interpretation of the act which will avoid a penalty or if there be two reasonable interpretations of the act and one of them will avoid the penalty, then the more lenient one shall be adopted.

You will therefore, gentlemen, by direction of the Court find a verdict for the defendant in this case, and the entries in the record will be in accordance with the practice established in this Court and approved by the Supreme Court in Oscanyan *vs.* Arms Co., 103 U. S., 261.

Mr. KOHLER: I except to your Honor's ruling. I would like also to except specifically on the ground that your Honor erred in stating that under the statute we are not entitled to have any copyright, and that Mr. Bong could not take out any copyright because Mr. Hernandez under the statute could not; also on the ground that your Honor held that Mr. Hernandez even at common law passed no common law copyright rights to Mr. Bong, the plaintiff, and also with regard to your Honor's construction of the proceedings by reason of their being for a penalty, that the question goes to the validity of the copyright itself, we have both equitable and legal remedies, and it is not a question peculiar to the enforcement of a penalty in this action: those specific exceptions, beside the first general one.

By direction of the Court, the jury rendered a verdict for the defendant, with exceptions to plaintiff.

19 Mr. KOHLER: "I ask for 60 days' time to prepare a bill of exceptions and a stay of execution.

Motion granted.

"The Court gives plaintiff leave on his application to move to amend the complaint if he deems such course advisable within ten days, on notice."

And this bill of exceptions contain all the evidence and proceedings on the trial hereof.

And for as much as none of the said matters and exceptions so offered and made to the rulings and directions of said Court do appear upon the records of said case, therefore, upon the prayer of said plaintiff by his counsel, the said Judge has signed and sealed this bill of exceptions in the presence of a representative of defendant within the term when said trial took place extended by orders regularly entered.

Dated New York, Jan. 9, 1907.

CHARLES M. HOUGH,
United States District Judge.

Settlement of within bill of exceptions consented to.

MAX J. KOHLER,
Att'y for Plaintiff.
BAGGOTT & RYALL,
Defendant's Attorneys.

(Endorsed:) United States Circuit Court, Southern District of New York.—Richard Bong, Plaintiff, against The Alfred S. Campbell Art Company, Defendant.—Plaintiff's Bill of Exceptions.—Max J. Kohler, Attorney for Plaintiff, 42 Broadway, New York City.—Copy received. Baggott & Ryall, Dec. 22, 1.29 P. M., 1906, 300 Broadway, N. Y.—U. S. Circuit Court, Southern District New York.—Filed Jan. 9, 1907.—John A. Shields, Clerk.

20 United States Circuit Court of Appeals for the Second Circuit.

RICHARD BONG, Plaintiff in Error,
against
THE ALFRED S. CAMPBELL ART COMPANY, Defendant in Error.

Assignment of Errors.

Plaintiff for his assignment of errors herein assigns that there was error to his detriment on the trial hereof for each and all of the following grounds:

1. That the Court directed judgment against plaintiff on plaintiff's opening to the jury by reason of plaintiff's concession that he would offer no proof as to the citizen- of the painter of the painting here involved.

2. Because the Court held that plaintiff, a subject of the Empire of Germany at all the times mentioned in the complaint, was not entitled to copyright a painting of which he is proprietor, painted by a subject or citizen of a foreign country, as to which the President has issued no proclamation under Section 13 of the Act of March 3, 1891 (1 Sup. Rev. St., p. 954).

3. Because the Court construed the said Act of March 3, 1891, as not authorizing copyright of a painting unless the painter be a citizen or subject of a country as to which the President has issued his proclamation under said statute, though the proprietor thereof be a citizen of such country.

21 4. Because the Court held that plaintiff could not acquire any common law copyright rights valid in the United States under an assignment from a Peruvian painter before publication of such painting.

5. Because the Court ignored and disregarded plaintiff's rights under the convention between the United States and Germany of January 15, 1892 (U. S. Statutes at Large, Vol. XXVII., pp. 1021-1022).

6. Because the Court held that a penalty under the copyright laws is a very noxious thing and requires a strict construction of the provisions of the act conferring copyright, even though equitable remedies are accorded by law in lieu and instead of penalties and forfeitures.

7. Because the Court construed the copyright law strictly against plaintiff, notwithstanding the requirements of fairness and utmost good faith towards persons claiming under a treaty with a foreign country.

8. Because the Court declined to permit plaintiff to adduce his evidence, but directed a verdict against plaintiff on plaintiff's opening.

Wherefore, plaintiff in error prays that the judgment of the Circuit Court be reversed, with costs.

New York, January 8, 1907.

MAX J. KOHLER,
Attorney for Plaintiff in Error.

22 Federal Union Surety Company.

Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit.

RICHARD BONG, Complainant,
vs.
THE ALFRED S. CAMPBELL ART COMPANY, Defendant.

Bond for Damages and Costs.

Know all men by these Presents, That the Federal Union Surety Company, a corporation organized under the laws of the State of Indiana and having its principal office in the City of Indianapolis, Indiana, and lawfully transacting business in the State of New York, and having its principal office in said State at No. 1 Madison Avenue, in the Borough of Manhattan, in the City of New York, is held and firmly bound unto the above named The Alfred S. Campbell Art Company, in the sum of two hundred and fifty ($250) dollars, to be paid to the said The Alfred S. Campbell Art Company, for the payment of which well and truly to be made, it binds itself, its successors and assigns, jointly and severally, firmly by these presents. Sealed with its seal, and dated the seventh day of January, in the year of our Lord one thousand nine hundred and seven.

Whereas, the above named Richard Bong has prosecuted an appeal to the United States Circuit Court of Appeals for the Second
23 Circuit, to reverse the decree rendered in the above entitled suit, by the Judge of the Circuit Court of the United States for the Southern District of New York,

Now, therefore, the condition of this obligation is such, that if the above named Richard Bong shall prosecute said appeal to effect, and answer all damages and costs if he fail to make his plea good, then this obligation shall be void, otherwise the same shall be and remain in full force and virtue.

FEDERAL UNION SURETY COMPANY,
By ROBERT M. NUGENT,
Resident Vice-President.

Attest:
F. STEARNS EDICK,
Resident Assistant Secretary.

Sealed and delivered, and taken and acknowledged this 7th day of January, 1907, before me,

[L. S.] CATHRYN F. ASPELL,
Notary Public, New York County.

Cert. filed in Kings, Queens, Suffolk, Richmond and Westchester Counties.

STATE OF NEW YORK,
County of New York, ss:

On this 7th day of January, 1907, before me personally appeared Robert M. Nugent, Resident Vice-President of the Federal Union Surety Company, with whom I am personally acquainted, who, being by me duly sworn, said that he resides in the County of New York, that he is the Resident Vice-President of the Federal Union Surety Company, the corporation described in and which executed the foregoing bond; that he knows the corporate seal of said company; that the seal affixed to the foregoing instrument is such corporate seal; that it was affixed by order of the Board of Directors of the said company, and that he signed said instrument as Resident
24 Vice-President of said company by like authority; and that the liabilities of said company do not exceed its assets, as ascertained in the manner provided by law and confirmed by an order of the Supreme Court of New York made and entered in New York County on March 30, 1904. And the said Robert M. Nugent, further said that he is acquainted with F. Stearns Edick and knows him to be the Resident Assistant Secretary of said company; that the signature of said F. Stearns Edick, subscribed to the said instrument, is in the genuine handwriting of the said F. Stearns Edick, and was thereto subscribed by the like order of the said Board of Directors, and in the presence of him, the said Robert M. Nugent, Resident Vice-President.

CATHRYN F. ASPELL,
Notary Public, New York County.

Cert. filed in Kings, Queens, Suffolk, Richmond and Westchester Counties.

Copy of By-Law.

Be it remembered, that at a meeting of the Board of Directors of the Federal Union Surety Company, duly called and held on the tenth day of July, 1901, a quorum being present, the following By-Law was adopted:

"ARTICLE VIII., SEC. 1. The President, Vice-President or Second "Vice-President may, from time to time, appoint Resident Vice-"Presidents, Resident Assistant Secretaries and Attorneys in fact, "to represent and act for, and on behalf of the Company; and either "the President, Vice-President, Second Vice-President, the Board of "Directors, or the Executive Committee may, at any time, remove "any such Resident Vice-President, Resident Assistant Secretary,

"or Attorney in Fact, and revoke the power and authority given
" him.
25 "SEC. 3. *Resident Vice-Presidents.*—Resident Vice-Presi-
" dents shall have power and authority to sign and execute
"on behalf of the Company, any and all bonds, recognization, con-
" tracts of indemnity and other writing obligatory in the nature
" thereof, and to bind the Company thereby as fully and to the same
" extent as the President could bind it.
" SEC. 4. Resident Assistant Secretaries shall have power and au-
" thority to affix the seal of the Company to, and attest, on behalf of
" the Company, any and all bonds, recognizances, contracts of in-
" demnity, and other writings obligatory in the nature thereof, as
" fully and to the same extent as the Secretary could bind it."

STATE OF NEW YORK,
County of New York, ss:

I, F. Stearns Edick, Resident Assistant Secretary of the Federal Union Surety Company, have compared the foregoing By-Law with the original thereof, as recorded in the Minute Book of said Company, and do certify that the same is a correct and true transcript therefrom, and of the whole of said original By-Law.

Given under my hand and seal of the Company, this 7th day of January, 1907.

[L. S.] F. STEARNS EDICK,
Resident Assistant Secretary.

(Endorsed:) United States Circuit Court, Southern District of New York.—Richard Bong, Complainant, against The Alfred S. Campbell Art Company, Defendant.—Bond for Damages and Costs. —Surety: Federal Union Surety Company.—I approve of the within bond, and of the sufficiency of the surety. C. M. Hough, U. S District Judge.—U. S. Circuit Court, Southern District New York.—Filed Jan. 10, 1907.—John A. Shields, Clerk.

26 *Citation.*

UNITED STATES OF AMERICA, *ss:*

To the Alfred S. Campbell Art Company, Defendant in Error, Greeting:

You are hereby cited and admonished to be and appear in the United States Circuit Court of Appeals for the Second Circuit, to be holden at the United States Court House and Post Office Building in the City of New York, on the 8th day of February, 1907, pursuant to a writ of error allowed and filed in the Clerk's office of the Circuit Court of the United States for the Southern District of New York, wherein Richard Bong is plaintiff in error, and The Alfred S. Campbell Art Company is defendant in error, to show cause, if any there be, why the error in the said writ mentioned should not be remedied and speedy justice should not be done to the parties in that behalf.

Dated New York, January 9, 1907.

C. M. HOUGH,
U. S. District Judge.

(Endorsed:) United States Circuit Court of Appeals Second Circuit.—Richard Bong, Plaintiff in Error, against The Alfred S. Campbell Art Company, Defendant in Error.—(Original) Citation, Writ of Error, Assignment of Errors, and Bond.—Max J. Kohler, Attorney for Plaintiff in Error, 42 Broadway, Borough of Manhattan, New York City.—Received a copy of the within Citation, Writ of Error, Assignment of Errors and Bond this 9th day of January, 1907. Baggott & Ryall, Attorneys for Defendant in Error.—To Baggot & Ryall, Attorneys for Defendant in Error.—U. S. Circuit Court, Southern District New York.—Filed Jan. 10, 1907.—John A. Shields, Clerk.

27 United States Circuit Court of Appeals for the Second Circuit.

No. 275, October Term, 1906.

Argued April 29, 1907; Decided May 30, 1907.

RICHARD S. BONG, Plaintiff in Error,
vs.
ALFRED S. CAMPBELL ART COMPANY, Defendant in Error.

In Error to the Circuit Court of the United States for the Southern District of New York.

Before Judges Lacombe, Townsend and Coxe.

This cause comes here upon appeal from a judgment of the Circuit Court, Southern District of New York, in favor of defendant in error who was defendant below.

Per Curiam:

This is an action under the copyright statutes to recover penalties and forfeitures for infringement of alleged copyright of a painting. Verdict in favor of defendant was directed by the court upon the pleadings and opening. It thereby appeared that one Hernandez was the author of the painting and that he was and always had been a citizen of Peru. The plaintiff is a citizen and subject of Germany.

Sec. 13 of the Act of March 3, 1891 (amending U. S. Rev.
28 Stat. Sec. 4952) provides that the copyright act shall apply only to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States the benefit of copyright on substantially the same basis as its own citizens, or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States by proclamation made from time to time. No such proclamation has ever been made as to Peru. It is conceded that Germany is within the terms of the section.

Prior to November, 1902, Hernandez executed documents purporting to convey to the plaintiff the right to enter the painting in his (plaintiff's) own name as proprietor for copyright protection in the United States, and also the exclusive right of reproduction in colors and also the exclusive right of engraving, etching, lithography in black and in colors, reserving, however, the right of photography and reproduction by all photographic monochrome processes. Thereafter plaintiff took the usual steps to secure copyright of the painting. For aught that appears the painting still belongs to Hernandez.

The peculiar form of assignment of rights of reproduction, conveying part and reserving part, presents an interesting question which need not be here discussed. The concessions as to citizenship are sufficient to dispose of the case. It has been held that when a person is the author or proprietor of a painting and has the right under our statute to secure a copyright on the same, he may separate the two, selling the right to take out a copyright to one person; while he himself retains the original painting or sells it, without copyright privileges to another person. We know of no authority which holds that when a person is the author or owner of a painting, but has no right under our statutes to secure a copyright here, he may nevertheless, while retaining the painting, convey to some one else what he does not own himself viz: the right to take
29 out copyright. In the absence of controlling authority we are unwilling so to hold, believing that such a construction would be judicial legislation defeating the very object which Congress by the 13th Section, above-cited, sought to obtain.

The judgment is affirmed.

M. J. Kohler, for the Plaintiff in Error.

Submitted for the Defendant in Error.

30 At a Stated Term of the United States Circuit Court of Appeals, in and for the Second Circuit, held at the Court Rooms in the Post Office Building in the City of New York, on the 10th day of June one thousand nine hundred and seven.

Present: Hon. E. Henry Lacombe, Hon. Alfred C. Coxe, Circuit Judges.

RICHARD L. BONG, Plaintiff in Error,

vs.

ALFRED S. CAMPBELL ART COMPANY, Defendant in Error.

Error to the Circuit Court of the United States for the Southern District of New York.

This cause came on to be heard on the transcript of record from the Circuit Court of the United States, for the Southern District of New York, and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged and decreed that the judgment of said Circuit Court be and it hereby is affirmed with costs.

E. H. L.

It is further ordered that a Mandate issue to the said Circuit Court in accordance with this decree.

31 Endorsed: United States Circuit Court of Appeals, Second Circuit. R. S. Bong, *vs.* Campbell Art Company. Order for Mandate. United States Circuit Court of Appeals Second Circuit. Filed Jun- 10 1907. William Parkin, Clerk.

32 Supreme Court of the United States.

RICHARD BONG, Plaintiff in Error,
against
THE ALFRED S. CAMPBELL ART COMPANY, Defendant in Error.

Assignment of Errors.

Plaintiff for his assignment of errors herein assigns that there was error to his detriment herein, in that the United States Circuit Court of Appeals for the Second Circuit affirmed the judgment of the United States Circuit Court for the Southern District of New York, dismissing the complaint, and assigns as error each and all of the grounds assigned in his assignment of errors in the United States Circuit Court of Appeals, as error, made to his detriment on the trial hereof in said Circuit Court and in said Circuit Court of Appeals, where said judgment was affirmed, and begs leave to refer and incorporate herein by reference, each and all of his assignment of errors in said United States Circuit Court of Appeals.

Wherefore, plaintiff in error prays that the judgment of the United States Circuit Court of Appeals in said Circuit, be reversed, with costs.

Dated, New York, June 29th, 1907.

MAX J. KOHLER,
Attorney for Plaintiff in Error.

33 Endorsed: Supreme Court of the United States. Richard Bong, Plaintiff in Error, against The Alfred S. Campbell Art Company, Defendant in Error. Assignment of Errors. Max J. Kohler, Attorney for Plaintiff in Error, 42 Broadway, Borough of Manhattan, New York City. Service of a copy of the within assignment of errors is hereby admitted this 3d day of July 1907. Baggott & Ryall, att'ys for def't in error. To Baggott & Ryall, attorneys for def't in error United States Circuit Court of Appeals, Second Circuit. Filed July 10, 1907. William Parkin, clerk.

34 United States Circuit Court of Appeals for the Second Circuit.

RICHARD BONG, Plaintiff in Error,
against
THE ALFRED S. CAMPBELL ART COMPANY, Defendant in Error.

Know all men by these presents, that the Federal Union Surety Company, a corporation organized and existing under the laws of

TORN PAGE

the State of Indiana, and lawfully transacting business in the State of New York, and having an office and usual place of business in said State at # 35 Nassau Street, Borough of Manhattan, City of New York, is held and firmly bound unto the above-named defendant, The Alfred S. Campbell Art Company in the sum of Two hundred and fifty ($250.00) Dollars, lawful money of the United States of America, to be paid to the said The Alfred S. Campbell Art Company, its successors or assigns, for the payment of which well and truly to be made we bind ourselves, our successors and assigns, firmly by these presents.

Dated, New York, June 28th, 1907.

Whereas the above-named Richard Bong has prosecuted a writ of error to the Supreme Court of the United States, to reverse the judgment of affirmance rendered in the above-entitled action in the United States Circuit Court of Appeals in and for the Second Circuit.

Now, therefore, the condition of this obligation is such that if the above-named Richard Bong shall prosecute the said writ of error to effect and answer all damages and costs if he shall fail to
35 make said plea good, then this obligation shall be void, otherwise the same shall be and remain in full force and virtue.

FEDERAL UNION SURETY COMPANY,
By F. STEARNS EDICK, *Res. Vice-President.*

Attest:
[L. S.] E. B. HOXIE,
Res. Ass't Secretary.

36 *Affidavit, Acknowledgment, and Justification by Federal Union Surety Company.*

STATE OF NEW YORK,
County of New York, ss:

On this 28th day of June, one thousand nine hundred and seven before me personally came F. Stearns Edick, known to me to be the resident vice president of the Federal Union Surety Company, the corporation described in and which executed the annexed bond of Richard Bong, as surety thereon, and who, being by me duly sworn, deposes and says that he resides in the City of Nyack, State of New York; that he is the Res. Vice-President of said Federal Union Surety Company, and knows the corporate seal thereof; that said Federal Union Surety Company is duly and legally incorporated under the laws of the State of Indiana; that said Company has complied with the provisions of the Act of Congress of August 13, 1894, allowing certain corporations to be accepted as surety on bonds; that the seal affixed to the annexed bond (Form —) of Richard Bong is the corporate seal of said Federal Union Surety Company, and was thereto affixed by order and authority of the board of directors of said Company; and that he signed his name thereto by like order and authority as resident vice president, of said Company, and that he is acquainted with E. B. Hoxie, and knows him to be the resident assistant secretary of said Company; and that the signature of said

E. B. Hoxie, subscribed to said bond is in the genuine handwriting of said E. B. Hoxie, and was thereto subscribed by order and authority of said board of directors, and in the presence of said deponent; and that the assets of said Company; unincumbered and liable to execution, exceed its claims, debts, and liabilities, of every nature whatsoever, by more than the sum of Three Hundred Thousand Dollars. Robert M. Nugent, of N. Y. City, New York, is attorney for service of process for the district in which this bond is given.

F. STEARNS EDICK.

Sworn to, acknowledged before me, and subscribed in my presence this 28th day of June, 1907.

[L. S.]

ESTHER BERG,
Notary Public, New York County.

Cert. filed in Kings, Queens, Suffolk, Richmond & Westchester Counties.

37 Endorsed: United States Circuit Court of Appeals, for the Second Circuit. Richard Bong, Plaintiff in Error, against The Alfred S. Campbell Art Company, Defendant in Error. Bond on Appeal. Max J. Kohler, Att'y for Pl'ff in Error, 42 Broadway, New York City. Approved as to form and also as to sufficiency of sureties, with reservation, however, to the —— of the right at any time to examine the proper officers of the Surety Company, under oath, touching its assets, liabilities and financial condition generally. H. G. Ward, U. S. Circuit Judge. United States Circuit Court of Appeals, Second Circuit. Filed Jul- 10, 1907. William Parkin, clerk.

38 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, William Parkin, Clerk of the United States Circuit Court of Appeals for the Second Circuit, do hereby Certify that the foregoing pages, numbered from 1 to 37 inclusive, contain a true and complete transcript of the record and proceedings had in said Court, in the case of Richard Bong, Plaintiff in Error, against Alfred S. Campbell Art Company, Defendant in Error, as the same remain of record and on file in my office.

In Testimony Whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 11th day of July, in the year of our Lord One Thousand Nine Hundred and Seven and of the Independence of the said United States the One Hundred and thirty- second.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN, *Clerk.*

39 *Citation.*

UNITED STATES OF AMERICA, *ss:*

To the Alfred S. Campbell Art Company, Defendant in Error, Greeting:

You are hereby cited and admonished to be and appear in the Supreme Court of the United States, to be holden in Washington, District of Columbia, on June 27th, 1907, pursuant to a writ of error allowed and filed in the Clerk's office of the United States Circuit Court of Appeals for the Second Circuit, wherein Richard Bong is plaintiff in error, and the Alfred S. Campbell Art Company is defendant in error, to show cause, if any there be, why the error in the said writ mentioned should not be remedied and speedy justice should not be done to the parties in that behalf.

Dated, New York, June 30th, 1907.

H. G. WARD,
United States Circuit Judge.

40 [Endorsed:] 2898. Supreme Court of the United States. Richard Bong, Plaintiff in Error, against The Alfred S. Campbell Art Company, Defendant in Error. Citation. Max J. Kohler, Attorney for Plaintiff in Error, 42 Broadway, Borough of Manhattan, New York City. Service of a copy of the within Citation is hereby admitted this 3rd day of July, 1907. Baggott & Ryall, Att'ys for def't in error. To Baggott & Ryall, Attorney- for Def't in Error. United States Circuit Court of Appeals, Second Circuit. Filed Jul- 10 1907. William Parkin, clerk.

41 *Petition for and Allowance of Writ of Error.*

UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Judges of the United States Circuit Court of Appeals for the Second Circuit:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said United States Circuit Court of Appeals, before you, or some of you, between Richard Bong, Plaintiff, and Plaintiff in Error, and The Alfred S. Campbell Art Company, Defendant, and Defendant in Error, a manifest error hath happened to the great damage of the said Richard Bong, Plaintiff, and Plaintiff-in-Error, as is said and appears by its complaint. We, being willing that such error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Justices of the Supreme Court of the United States, at Washington, District of Columbia, together with this writ, so that you have the same at the said place, before the

Justices aforesaid, within thirty days from the date hereof, that the record and proceedings aforesaid being inspected, the said Justices of the Supreme Court of the United States may cause further to be done therein to correct that error, what of right and according to the law and custom of the United States ought to be done.

Witness, the Honorable Melville W. Fuller, Chief Juustice of the United States, this 30th day of June, in the year of our Lord one thousand nine hundred and seven, and of the Independence
42 of the United States the one hundred and thirty-first.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WILLIAM PARKIN,
Clerk U. S. Cir. Court of Appeals.

The foregoing writ is hereby allowed.

H. G. WARD,
United States Circuit Judge.

June 30, 1907.

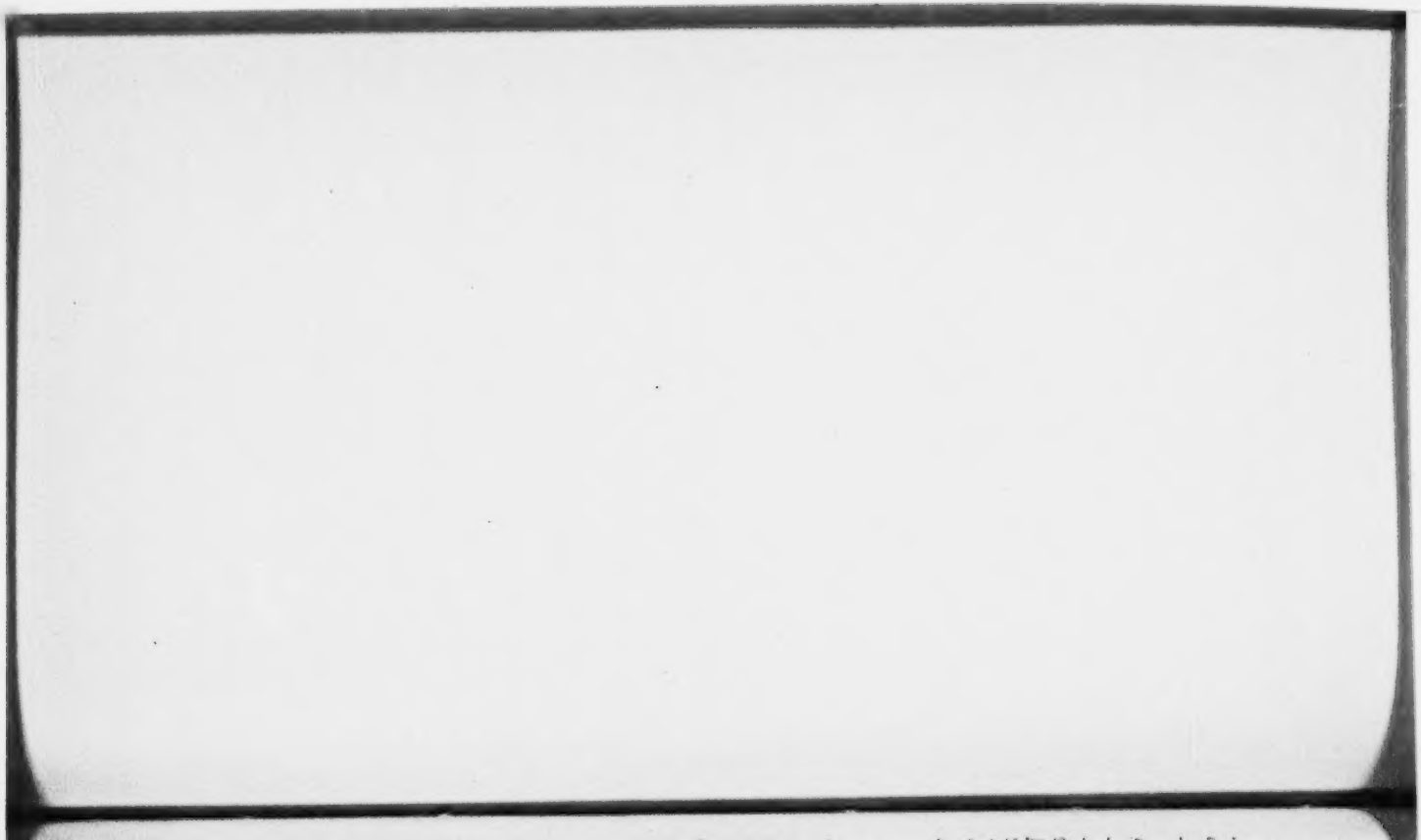
To the Honorable the Justices of the Supreme Court of the United States:

Richard Bong, plaintiff, and plaintiff in error, in a certain action entitled Richard Bong, Plaintiff, against The Alfred S. Campbell Art Company, defendant, and defendant in error, pending in the United States Circuit Court for the Southern District of New York, and carried by appeal to the United States Circuit Court of Appeals for the Second Circuit, and there decided against said plaintiff and plaintiff in error, on or about the tenth day of June, 1907, hereby applies for the allowance of the accompanying writ of error. Dated, New York, June 30, 1907.

MAX J. KOHLER,
Attorney for Plaintiff in Error, 42 Broadway, New York.

43 [Endorsed:] 2898. United States Circuit Court of Appeals, Second Circuit. Richard Bong, Plaintiff in Error, against The Alfred S. Campbell Art Company, Defendant in Error. Petition for and Allowance of Writ of Error & Writ of Error. Max J. Kohler, Attorney for Plaintiff in Error, 42 Broadway, Borough of Manhattan, New York City. Service of a copy of the within Writ of Error, etc. is hereby admitted this 3rd day of July, 1907. Baggott & Ryall, Att'y- for Def't in Error. To Baggott & Ryall, Attorneys for Def't in Error. United States Circuit Court of Appeals, Second Circuit. Filed Jul- 10, 1907. William Parkin, clerk.

Endorsed on cover: File No. 20,816. U. S. circuit court of appeals, 2d circuit. Term No. 150. Richard Bong, plaintiff in error, *vs.* The Alfred S. Campbell Art Company. Filed July 27, 1907. File No. 20,816.



(1)

Supreme Court of the United States

No. 150.

RICHARD BONG,

Plaintiff-in-Error,

against

THE ALFRED S. CAMPBELL ART COMPANY,

Defendant-in-Error.

BRIEF FOR PLAINTIFF-IN-ERROR.

MAX J. KOHLER,
of Counsel for Plaintiff-in-Error.

THE REPORTER CO., WALTON, N. Y.
N. Y. Office, Gaston Watson Russell,
[illegible] Broadway, Room [illegible], Telephone [illegible] Gort.

Supreme Court of the United States

OCTOBER TERM, 1908. No. 150.

RICHARD BONG,
Plaintiff-in-Error,

against

THE ALFRED S. CAMPBELL ART COMPANY,
Defendant-in-Error.

BRIEF FOR PLAINTIFF IN ERROR.

This is a writ of error in a copyright case to review the judgment of the U. S. Circuit Court of Appeals for the Second Circuit, affirming the judgment of the U. S. Circuit Court for the Southern District of New York, dismissing the complaint on plaintiff's opening.

Plaintiff in error, who was plaintiff below, brought this action to recover $10,000.00 penalties and forfeitures under Section 4965, as amended, of the U. S. Revised Statutes for infringement by defendant of his copyright of the painting "Dolce far niente" by the well-known painter, Daniel Hernandez. The complaint avers that the copyright application papers were duly filed by plaintiff with the Librarian of Congress on or about November 8th, 1902 (Record, p. 4), and that plaintiff thereafter duly published reproductions of the ~~same~~ painting (p. 4); that plaintiff at that time and ever

since was a subject of the Empire of Germany, as to which country the President of the United States had issued a proclamation (27 Stat. at L., p. 1021) under Section 13 of the Act of March 3rd, 1891, as to Copyrights (1 Sup. Rev. St., p. 951); and that the painter Hernandez was a subject of Spain, as to which country a similar proclamation had been issued by the President (p. 3), and that plaintiff had become the lawful and sole "proprietor" of said painting by due assignment prior to the copyrighting (p. 3). Defendant was charged with copying this painting without plaintiff's consent (p. 4).

On the trial, plaintiff's counsel in his opening conceded that he would offer no evidence to establish the citizenship of Hernandez and would not controvert the statement made by the defense that he was a citizen of Peru, as to which country the President had issued no copyright proclamation (p. 9). Defendant moved for a direction of a verdict on this concession, and the Court, after argument, granted the motion on the authority of Yuengling vs. Schile, 12 Fed. Rep., 97, because the painter is not a citizen of a country within our copyright proclamations, notwithstanding plaintiff's objections and exceptions and request to proceed with the trial (pp. 10-11).

The Court also examined a written conveyance executed in Paris by Hernandez to Bong on June 1st, 1902, of American copyrights rights in the painting (p. 9), and also a license covering exclusive right of reproduction in certain arts, for a valuable consideration (p. 9). Plaintiff's counsel admitted that he never owned the physical painting.

The Spanish name of the painter and his residence in Europe obviously suggested to plaintiff his Spanish citizenship, which was averred in the complaint, but which incorrect allegation was treated as surplusage on the trial, in view of Hernandez's deposition in this suit.

The Circuit Court of Appeals treated the case as if Hernandez was still the owner of the painting, but the case having been disposed of by a motion on plaintiff's opening he is of course entitled to have all the allegations of his complaint treated as admitted, except his admission as to citizenship (see *post* Point VIII). Accordingly under authority (103 U. S., at 266) it is not improper to point out here that Signor Hernandez's testimony on depositions taken by defendant and on file in the Circuit Court shows that before copyrighting here he sold the painting to Mr. Wolf of Munich, with reservation of copyright rights, and at the same time executed the assignments to plaintiff (p. 9) and transferred simultaneously to F. Hanfstengel of Munich the remaining rights to reproduction by photography and by monochrone process. At the time of the copyrighting, the painting and all rights to reproduce it were vested in subjects of Germany (Hernandez Depositions, Answers to Interrogatories 6, 8, 9, 15, 16, 17, 20, 21, 35).

The case involves the construction for the first time of the provisions of the International Copyright Law in their bearings upon the question whether both the author and the proprietor or assigns of a work must be citizens of countries within the President's copyright proclamations. The statutory provisions involved are as follows:

Sec. 4952, as amended March 3rd, 1891 (1 Sup. Rev. St., p. 951) reads:

> "The *author*, inventor, designer or *proprietor* of any book, map, chart, * * * painting * * * and the executors, administrators and *assigns* of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing finishing and vending the same, etc."

Section 13 of this Act of March 3rd, 1901, further provided:

> "That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens, or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States by proclamation made from time to time as the purposes of this act may require." (1 Sup. Rev. St., p. 954.)

The same statute amended Section 4952, above quoted, by striking out the words with which it originally began:

> *"Any citizen of the United States or resident therein who shall be"* (the author, inventor, designer or proprietor, etc., or "assign").

Secs. 4954 and 4967 were amended at the same time in the same way by this act.

Sec. 4956, as amended by this act, required that the copy of the book, etc., to be filed must have been printed from type set in the United States, a new provision in our laws.

It also repealed absolutely in terms, by its section 10 (1 Sup. Rev. St., p. 954) Sec. 4971 of the Rev. Statutes, which had read:

> "Nothing in this chapter shall be construed to prohibit the printing, publishing, importa-

> tion or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving or photograph written, composed or made by any person not a citizen of the United States nor resident therein."

The repeal provision (Section 10) reads:

> "That section forty-nine hundred and seventy-one of the Revised Statutes be and the same is hereby repealed."

Section 4971 of the Revised Statutes had been the only one in the title relating to Copyrights which concerned itself with the country of production of the work specifically.

Plaintiff in error claims that as he was the "proprietor" and "assign" of the author and proprietor of the painting under Sec. 4952 as amended, and himself a "citizen or subject of a foreign nation," with which we have copyright relations within the purview of Sec. 13 of the Act of March 3rd, 1891, his copyright is valid, though the painter was not such citizen or subject.

POINT I.

The plain and unambiguous language of the Act of March 3rd, 1891, confers copyright where the person applying for the same as proprietor or assign of the author or proprietor is a subject of a country with which we have copyright relations, whether the author be a subject of one of those countries or not.

(a) *Sec. 13 of the Act of 1891 is satisfied if the "proprietor" or "assign" taking out the copyright is a citizen of a country with which we have copyright relations.*

Sec. 4952, as amended in 1891, it will have been observed, authorizes either the "author" or proprietor" of a work, "or his executors, administrators or *assigns*," to copyright the same The only limitation upon this is found in Section 13, which provides that this shall only "apply to a citizen or a subject of a foreign state" as to which the President has issued his proclamation. The statute does not limit copyright to cases where the *author* of the work is such subject or citizen, but uses general language appropriate to the disjunctive language of Section 4952. The statutes thus address themselves merely to the question presented by the application for copyright, which may be submitted by either *author, proprietor* or *assign,* and the person making the application for copyright, under Section 13, must be such citizen or subject. There is no suggestion of any limitation to citizenship of country of production, and the only statute that had contained any such limitation, Sec. 4971, was expressly repealed. The purpose of limiting statutory copyright to work of Americans, supposed to have actuated Congress before 1891, as held by District Judge Brown in 1882, in *Yuengling vs. Schile,* 12 Fed. Rep., 97, was thus expressly abandoned by Congress after a struggle which had lasted for many decades and which had several times been aided by recommendations in Presidential messages.

Of course, effect has repeatedly been given since 1891 to these statutes in as far as they permitted foreigners to acquire copyright protection.

American Tobacco Co. vs. Werckmeister, 207 U. S. 284 aff. 146 F. R., 375 (CCA).

Werckmeister vs. Am. Lith. Co., 134 Fed. Rep., 321 (CCA); 142 F. R., 827 (Holt, J.); aff. 146 Fed. Rep., 377 (CCA) aff. 207 U. S., 375;

Werckmeister vs. Springer Lith. Co., 63 Fed. Rep., 808 (Townsend, J.).

Werckmeister vs. Pierce, 63 F. R., 445.
Merriam Co. vs. United Dictionary Co., 146 Fed. Rep., 354 (CCA) aff. 208 U. S., 260.
Oliver Ditson Co. vs. Littleton Co., 62 Fed. Rep., 597.

The only reported case, however, which seems to have contained even a remote consideration of the branch of the statute here involved in Ency. Britannica Co. vs. Werner Co., 135 Fed. Rep., 841, 844, where Judge Lanning, in a case involving a book, paraphrased the statute as here contended for:

> "Previous to 1891 the protection of our copyright laws was extended only to citizens and residents of the United States. Sec. 4971 of the Revised Statutes expressly provided that nothing in the copyright law should be 'construed to prohibit the printing, publishing, importation or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving or photograph written, composed or made by any person not a citizen of the United States nor resident therein.' On March 3rd, 1891, the law was amended by extending to *any foreign author or proprietor* of any book, and the executors, administrators or *assigns* of such author or proprietor, the privileges of our copyright law."

In the amendment of Sec. 4952 concerning copyrighting foreign books issued in foreign languages, adopted March 3rd, 1905 (Vol. 33 Stat. at Large, p. 1000), Congress transferred the provision of Sec. 13 to Section 4952 itself as a proviso, this part reading:

> "Provided, That this Act shall only apply to a citizen or subject of a foreign State or nation when such foreign State or nation permits to citizens of the United States of America

> the benefit of copyright on substantially the same basis as to its own citizens,"

clearly recognizing that this limitation as to foreign citizenship was intended to apply to the author *or* proprietor or his assign authorized to take out a copyright by Section 4952.

(b) *It is, of course, now well settled that since Section 4952 was first enacted, in the revision of July 8, 1870, the "proprietor" or "assign" of the author, as well as the author himself, has been permitted to take out a copyright in his own name, the Act of 1870, expressly interpolating the words "proprietor" when paintings were first made copyrightable.* (Statute at Large, Vol. 16, p. 212; Solberg's Copyright enactments of the U. S., p. 46).

> Am. Tobacco Co. vs. Werckmeister, 207 U. S., 284, 296-9, affirming 146 Fed. Rep., 375 (CCA).
>
> Werckmeister vs. Pierce Co., 63 Fed. Rep., 445, 449-452.
>
> Werckmeister vs. Springer Lith. Co., 63 Fed. Rep., 808, 810-2.
>
> Werckmeister vs. Am. Lith. Co., 142 Fed. Rep., 827, 830-2 (Holt, J.); aff. 146 Fed. Rep., 377 (CCA).
>
> Mifflin vs. White Co., 190 U. S., 260, 262.
>
> Lawrence vs. Dana, 4 Cliff., 1; 15 Fed. Cases, 8136.
>
> Parton vs. Prang, 3 Cliff., 537; 18 F. C., 10-784.
>
> Callaghan vs. Myers, 128 U. S., 617, 658.

Says this Court in Mifflin vs. White, *supra*:

> "The word 'proprietor' must practically have the same meaning as 'legal assigns' in the first section, and was designed to give to the legal assignee of any author or authors the right to take out the copyright in his own name."

In American Tobacco Co. vs. Werckmeister, 207 U. S., 284, 296-9, this Court said, since the decisions below in this case:

> "Again, it is contended that under the facts stated, Werckfeister was but the licensee of Sadler, and as such not within the terms of the statute (4952 as amended 1891, 26 Stat., 1107; 3 U. S. Comp. Stat., p. 3406) * * * But we think *the transfer in this case accomplished what it was evidently intended to do, a complete transfer of the property right of copyright existing in the picture.* There is no evidence of any intention on the part of Sadler to retain any interest in this copyright after the sale to Werckmeister; and when the painting was offered for sale at the Royal Academy it was with a reservation of the copyright.
>
> It would be an entirely too narrow construction to this instrument to construe it to be a mere license or personal privilege, leaving all other rights in the assignor. That it was the purpose of the parties to make a complete transfer is shown by the instrument executed when read in the light of the attendant circumstances.
>
> In this connection *it is argued* that under the statute above quoted (sec. 4952 as amended, March 3rd, 1901), an author cannot, before publication, assign the right or privilege of taking a copyright independent of the transfer of the copyrightable thing itself, and it is contended that the terms, author, inventor, designer, refer to the originator of the book, map, chart, painting, etc., and *that the term "proprietor" refers to the person who has a copyrightable thing made for him* under such circumstances as to become the proprietor, as, for instance, one who causes a digest to be compiled or a picture to be painted. But *we think*

this statute must be construed in view of the character of the property intended to be protected. That it was intended to give the right of copyright to others than the author, inventor to designer is conclusively shown in the use of the terms 'proprietor' and 'assigns' in the statute.

It seems clear that the word 'assigns' in this section is not used as descriptive of the character of the estate which the 'author, inventor, designer or proprietor' *may acquire under the statute,* for the 'assigns' of any such person, as well as the persons themselves, may, 'upon complying with the provisions of this chapter,' have the sole liberty of printing, publishing and vending the same. *This would seem to demonstrate the intention of Congress to vest in 'assigns,' before copyright, the same privilege of subsequently acquiring complete statutory copyright as the original author, inventor, designer or proprietor has.* Nor do we think this result is qualified because the statute gives to assigns, together with the right of publishing, vending, etc., the right of 'completing, executing and finishing' the subject-matter of copyright.

And a strong consideration in construing this statute has reference to the character of the property sought to be protected. *It is not the physical thing created, but the right of printing, publishing, copying, etc., which is within the statutory protection.* * * * While it is true that the property in copyright in this country is the creation of statute, *the nature and character of the property grows out of the recognition of the separate ownership of the right of copying from that which inheres in the mere physical control of the thing itself, and the statute must be read in the light of the intention of*

Congress to protect this intangible right as a reward of the inventive genius that has produced the work. We think every consideration of the nature of the property and the things to be accomplished supports the conclusion that this statute means to give to the assigns of the original owner of the right to copyright an article the right to take out the copyright secured by the statute, independently of the ownership of the article itself."

(c) The Copyright Laws containing at present no limitation as to *country of production* of the work and Section 13 having nothing to apply to except the provisions of Section 4952, amended at the same time this statute was adopted, and establishing the rights of persons to take our copyrights, either as "author," "proprietor" or "assign," it seems obvious that the law requires merely that the person taking out the copyright must be a citizen of such country, irrespective of the nationality of the author. *The views expressed below as to supposed policy against such construction, correct or incorrect, should therefore be disregarded,* as were similar views in U. S. vs. Goldenberg, 168 U. S., 95, where Mr. Justice Brewer, speaking for the Court, said:

> "The question must be answered in the negative. Such answer is demanded by the obvious and natural import of the language, giving to it the ordinary grammatical construction * * * The primary and general rule of statutory construction is that the intent of the law-maker is to be found in the language that he has used. He is presumed to know the meaning of words and the rules of grammar. The courts have no function of legislation, and simply seek to ascertain the will of the legislator. * * * No mere omission, no mere failure to provide for

contingencies, which it may seem wise to have specially provided for, justify any judicial addition to the language of the Statute."

If it had been the intention of Congress to limit copyright to the work of authors of the specified countries, it could easily have said so, and the very matter was under consideration by the law-making body, as is shown by the express repeal of Section 4971. The debates in Congress and the reports of the committees lead to the same conclusion and show an intent to bring the United States within the broader policy of the Berne Convention, subject to a preservation of our policy to protect domestic printers and engravers by the "printed in the United States," provision of Section 4956 as amended. (See *post.*)

(d) *In fact, the experience and legislation of the rest of the civilized world, antedating the framing of this Act, led to the adoption by them of a policy protecting works published in a country, as well as those by native authors or artists, and it was undoubtedly the purpose of Congress to adopt such policy.*

The various international conferences which had considered copyright protection noted the fact that a scheme for protecting native authors and artists only (possibly together with alien residents), left without protection works by aliens *published* by natives, and left works by natives published abroad in an uncertain condition. Accordingly, at the Berne International Copyright Conference, while Germany at first opposed a proposition to give protection to all works published on union territory, though by non-unionist authors, in addition to works by unionist authors, she thereafter consented to a compromise by which publishers of foreign works might be protected, as was the case already under subsisting German law. Accordingly Article 3 of the Berne Convention was adopted in this new form, reading:

"The stipulations of the present Convention apply to the *publishers* of literary or artistic works published in any country of the Union, though the author belongs to a country which is not a party to the Union."

See:

Briggs's The Law of International Copyright, pp. 288-290, 671, comparing also the provisions of Articles 2 and 5 (*Id.*, pp. 669, 673).

In 1896, when article 3 was amended it was further enlarged by the International Convention by granting protection to foreign non-unionist authors first publishing or causing first publication in a country of the union (*Id.*, p. 671).

The German law of 1870, in force when the first Berne Convention met, since made more liberal, reads:

"The present law applies to all works of native authors, whether such works have appeared within the country or abroad, or have not been published at all. The works of foreign authors which appear at the house of a publisher having his business establishment in the territory of the North German Confederation shall also enjoy the protection of the present law."

England issued orders in council in December, 1887, enforcing the Berne Convention, containing Section 4, reading as follows (Briggs, *Id.*, p. 767):

"The rights conferred by the International Copyright Acts 1844 to 1886 shall, in the case of a literary or artistic work first produced in one of the foreign countries of the copyright union by an author who is not a subject or citizen of any of the said foreign countries, be limited as follows, that is to say, the author shall not be entitled to take legal proceedings in

> Her Majesty's dominions for protecting any copyright in such work, but *the publisher of the work shall* for the purpose of any legal proceedings in Her Majesty's dominions for protecting any copyright in such work, *be deemed to be entitled to such copyright as if he were the author, but without prejudice to the rights of such author and publisher as between themselves.*"

(This is in line with the recommendations of the eminent specialists who constituted the "British Commission appointed in 1878 by the Queen for the Investigation of the Subject of Copyright,") (Report reprinted in Putnam: "The Question of Copyright," 2nd Edition, pp. 228, 233, Articles 62 and 96).

This Court, in White Smith Music Pub. Co., vs. Apollo Co., 209 U. S., 14, 15, just said of the Berne Convention of 1886, that "the proceedings of the convention were doubtless well-known to Congress," and attributed to Congress an intent to make similar provision. Of course, this very act, in its Sec. 13, referred to the Berne "International Agreement" whose proceedings had been officially communicated by the President to Congress and which had been published as official documents (House Exec. Document No. 354, 49th Congress, 1st Session and House Exec. Doc. No. 37, 49th Cong., 2nd Session). In his Annual Message of Dec. 8, 1885 Pres. Cleveland in fact said: "Action is certainly desired to effect the object in view * * * The matured views of the Berne conference cannot fail to aid your consideration of the subject."

The case of Interstate Comm.-Comm. vs. B. & O. R. Co., 145 U. S., 263, is also in point as it construed our Interstate Commerce Act in accordance with the English Act on which it was modelled.

It should, moreover, be noticed, that when striking out the limitation as to American production (sec. 4971), *and prescribing that the person taking out the*

copyright must be a citizen of the United States or of a proclaimed country, Congress had also covered in general, the question of American publication, not merely for works by aliens but even as to our own citizens, by the provisions of Sec. 4956 as now amended, as to American printing of the published books, protograph, chromo lithograph. Authorship limitation thus became unnecessary, under the policy now adopted.

(e) In the face of the conclusions and experiences of all Europe, a court would be rash indeed when these facts are brough before it, to say that *public policy* required a strict construction of our copyright protection to citizen or "proclaimed" "authors." In fact, however it is the consensus of opinion abroad that it is unwise to pursue a retaliatory policy in copyright matters and certainly the United States cannot afford to welcome such policy (See Briggs, *Id.*, pp. 99-101, 142). The British copyright Commission of 1878 advise against such course with particular reference to the United States, saying:

"It has been suggested to us that this country would be justified in taking steps of a retaliatory character, with a view of enforcing incidentally that protection from the United States which we accord to them. This might be done by withdrawing from the Americans the privilege of copyright on first publication in this country. *We have, however, come to the conclusion that on the grounds of highest public policy and expediency it is advisable that our law should be based on correct principles, irrespective of the opinion or the policy of other nations.*" (Putnam, Id., p. 273).

In fact, however, the learned trial judge should have considered additional factors in taking account of questions of supposed policy, which lead to the very opposite result. Judge Hough thought that a holding in favor of the validity of this copyright would enable our policy of restriction to countries affording our

citizens reciprocal copyright protection, to be circumvented (pp. 10-11). Of course, even, on his theory, American owners by assignment of such copyrights from foreign authors would be apt to be similarly treated abroad, and thus to that extent, at least, our policy of reciprocity would be avoided or subserved as the case may be. Bitter feeling and resentment would at once be aroused by such determination on the part of the United States with respect to the large amount of capital invested in such assigned rights, which are recognized everywhere else. The present case concededly involves no mere colorable assignment, but a *bona fide* assignment and license to a German plaintiff, for value, under which he has manufactured photogravure reproductions of the painting for his own individual benefit. If, however, the *bona fides* of an assignment are to be inquired into, that could be made the subject-matter of proof, but does not justify avoiding all assignments, *bona fide* or colorable (see Point IV post). It is obvious that, as in the present case, the assign of copyright rights, whether an American citizen or a subject of a country with which we have copyright relations, would be apt to bring to his domicile the advantages resulting from the industry of reproducing, so that both the "author" and the "proprietor" and his employees are likely to benefit. Congress would thus have an excuse for its legislation in addition to recognition of mere "property rights of authors," if such additional excuse must be found.

In fact, however, Judge Hough assumes without proof that other countries now discriminate or are likely to discriminate against works of American authors, though in fact almost every civilized country in the world already has copyright relations with us (Solberg Copyright Enactments, pp. 87-105) so at best the danger is trifling. Much more serious is the limitation now sought to be put upon our copyright relations with other countries, by limiting protection to "authors" and excluding "proprietors" and "assigns" who are sub-

jects of these countries.' The other countries have not thus limited their own copyright protection thus far. In fact, unlike nearly every other country we have been curtailing copyright protection, notwithstanding Senator Clay's masterly exposition of the natural rights of authors in his Senate report in favor of an International Copyright Law already in 1837 (Putman: The Question of Copyright, 2nd Ed., pp. 33-39). The Committee of Congress which reported this International Copyright Act, in its report to Congress, prepared by Mr. Simonds, dated June 10th, 1890, succinctly described the then existing situation thus:

> "Without reference to international agreements every one of the twenty-six countries above named (including Germany) permits foreigners to take copyright on the same basis as its own citizens, except Great Britain * * *
>
> "By Acts of Parliament the queen is empowered to provide for copyright of an international character as to any nation which will reciprocate. From conditions herein pointed out, it is clear that the queen is thus empowered, solely with reference to hoped for relations with the United States.
>
> *The United States alone refuses copyright to foreigners, and alone among the nations of the earth refuses reciprocity in copyright.* * * * The United States must give in its adhesion to international copyright or stand as the literary Ishmael of the civilized world." (Putnam, id., pp. 80-1, 83, House Rep., No. 2401, 51st Congress, 1st Session.)

Substantially all Europe belongs to the Berne Copyright Union, and several South American States, (including Peru), to the Montevideo Copyright Union

On the other hand, though it was clearly intended by Section 13 of the Act of March 3rd, 1901, to confer copyright protection on all the countries belonging to those unions, including Peru (see post Point VI) we have denied those countries protection under our laws as such, and have even failed to issue proclamations as to some states which afford equal copyright rights unconditionally to alien and citizen alike (see Briggs, *Id.*, pp. 659-660). Naturally every foreigner is likely to assume that assignments to publishers pass valid right to copyright in the United States as well as at home, and this conclusion is confirmed by an examinaton of our statutes, which on their face at least confer such right. Besides, as shown *post* such has been the general understanding in Europe of the American law, as shown by their text books and other authorities (see *post* p22-3). This case as decided below, would create a decided limitation even upon American protection as heretofore understood.

On the question of public policy, then, it is obvious that an attempt, by judicial construction, still further to limit the right to copyright even of foreign assigns who are subjects of countries with which we have copyright relations, would be apt to result in serious reprisals, working strongly to the disadvantage of American authors and publishers. Neither public policy, nor our policy of reciprocity in copyright, calls for any such restriction by judicial construction, and the remote possibility of such denial of rights of American proprietors abroad, referred to below, does not justify reading such unexpressed limitations into the statute.

(f) *Moreover, if the language of these statutes is to be limited by judicial construction, what is to fix the bounds of this restriction?* Apparently Judge Hough thinks Sec. 13 is to be construed as applicable only to works produced by citizens of countries as to which the President's proclamation has been issued. At that rate, even residents within the United States that are

citizens of other countries, who expressly enjoyed copyright protection under our statutes before 1891 (Carey vs. Collier, 56 Niles Reg., 262, 5 Fed. Cases, 2400; Boucicault vs. Wood, 2 Biss., 34, 3 Fed. Cases, 1693), are also cut off from protection, though no reason for such curtailment suggests itself. Even American citizens who are assignees of such resident foreigners, cannot acquire copyrights, under this construction. A passage in Judge Hough's opinion (p. 10), indicates that he would possibly not apply his rule to *owners of the physical painting*, but merely to assigns of the copyright rights, notwithstanding the opinion since rendered by this court in the Werckmeister case, but where can one find any basis for such a distinction in the statutes here involved? And if Section 13 is to be construed as applicable merely to country of production, it would have to be held, notwithstanding the statutes, that a foreign assign of such an artist, where the assign is not a subject of any country with which we have copyright relations, could take out a copyright, despite the language of our statutes and reciprocity policy. Or is the statute to be construed to require both author and proprietor of the copyright rights to be such subject? Obviously there would be no bounds to such judicial lawmaking.

(g) *Something was said on the trial as to an alleged construction by the Librarian of Congress of our copyright laws against recognizing rights based upon assignments from authors who are citizens of countries not covered by proclamations.* The fact of such construction is challenged; to counsel's own knowledge a copyright was granted after consideration of this question in 1901, some years before the copyright proclamation as to China, for a work by a Chinese author, the manuscript of which had been assigned to an American, A. S. Taylor. The Copyright Bureau in fact has stated that the question is a doubtful one requiring determination. (Report on Copy-

right Legislation by the Register of Copyrights for the year ending June 30, 1903, pp. 10-11.) If there be any such construction as contended for by defendant, however, it is submitted that it is obviously wrong and is not uniform, long established nor reasonable, so as to be entitled to any weight as an alleged departmental construction, (U. S. vs. Graham, 110 U. S., 219, U. S. vs. Tanner, 147 U. S., 661). Nor, as he himself conceded, is the Librarian of Congress given any discretionary power, but he is a mere ministerial officer (Putnam Id., pp. 31-2).

(h). *Even before the International Copyright Law Amendment of* 1891, *however, it is submitted that the proprietor of a painting who was himself a citizen or resident of the United States, could have secured a copyright, even though the artist may have been a non-resident alien,* but the rule was different as to books and other articles enumerated in Section 4971, because of the express provisions of that section. It must be conceded that the dicta of Judge Brown in the Circuit Court in *Yuengling vs. Schile,* 12 Fed. Rep., 97 (as far as this case is based on grounds other than that a "chromo" is a "print" under 4971), was to the contrary, and this case was relied upon by defendant below, but the question involved in that case, as to copyrightability (in 1880) before our International Copyright Act of a painting by an alien artist, of which an American citizen was proprietor, was not adjudicated in any other case, and we submit that this decision was incorrect. Paintings were first made copyrightable under any federal statute by the revision of our Copyright Laws of 1870 (16 Stat. L. p. 212, Sec. 86), and it was this statute which, as Judge Brown points out, in terms first permitted "proprietors" of literary and artistic property to take out copyrights as such (p. 102). In the same statute (Sec. 103), as well as its re-enactment, Sec. 4971, enumerating the articles which Congress specified

were not forbidden to be printed, published, imported or sold if "made by any person not a citizen of the United States, nor resident therein," the group consisting of a painting, drawing, chromo, statue, statuary" was not included with "books, map, chart, etc." *There was, therefore, no limitation of copyright to works produced by American citizens or residents as to this group of works of art, unlike books, but Judge Brown treated this omission as merely "accidental" and ineffective* (p 103), *and read into the statute by judicial legislation, as limiting the term "proprietor," the additional words "proprietor of a work by a native author,"* "viz., as meaning the lawful owner and representative whether by assignment, employment, death, or other lawful succession of the exclusive rights of some *native or resident* author or artist only."

This construction runs counter to the principle of law against judicial legislation, condemned in the Goldenberg case *supra*. With respect to this very statute and this very grouping of works of art, it runs directly counter to the construction of this Court, in the subsequently decided case of *Thornton vs. Schreiber*, 124 U. S., 612, 615-616, to the effect that under the statues, before the amendment of 1895, (28 Stat. at L. 965), one-half of the penalties recovered as to "paintings, statue and statuary" went to the United States, unlike the case of "maps, charts, photographs," etc. This distinction in the language between these varying groups was uniformly enforced.

See also as to similar distinctions between the two groups with respect to limitation of penalties to "copies found." Says the Circuit Court of Appeals as to infringements of paintings in Am. Lith. Co. vs. Werckmeister, 146 F. R., 377:

> "It is not necessary to inquire why this distinction is made; it is sufficient to say that it is made in language so plain that to eliminate it would be judicial legislation."

The circumstances that American owners of valuable foreign and domestic paintings and statues might want to copyright them, suggested not merely the inclusion of "paintings" as copyrightable, but the more apt designation of their owners as "proprietors," and also of provisions for their "assigns," and the elimination of a stupid restriction to American production, never made applicable to paintings. It should be remembered that works of art, unlike manuscripts, commonly retained value in their unpublished form for generations, so that statutes designed to protect rights in them necessarily had to reckon with their proprietors, as well as their authors, and their assigns. Congress recognized this factor in framing the act of 1870.

This was the same careful revision of 1870 of the patent and copyright laws, which was involved in Bate Refrigerating Co. vs. Sulzberger, 157 U. S., 1, recognizing foreign patents.

In as far as *Yuengling vs. Schile* was based on the theory of supposed policy of limitation of copyright protection to American works, this was, of course, controverted in part by the statutory recognition of resident aliens at this date already, and was definitely abandoned when our International Copyright Law was passed in 1891.

Section 4952, before its amendment in 1891, had repeatedly been construed by writers on copyright, however, in its relation to paintings and other works of art as permitting copyright by an American proprietor or assign of a foreign work, because "paintings" were not embraced by the terms of Sec. 4971 which embraced books, maps, etc., merely. These authorities were evidently not called to Judge Brown's attention.

Drone, our leading American authority on copyright, said in his book (pp. 231-2):

> *"But there is no mention in this section (5271) of paintings, drawings, chromos, sta-*

tues, statuary, models or designs, and there is nothing in that statute to prevent a resident owner of any such production from securing a valid copyright therein, though it be the work of a foreigner."

Darras, long the chief European authority on International copyright, in his work "*Du Droit des Auteurs & Des Artistes dans les Rapports Internationaux*" (Paris, 1887), takes the same view (pp. 364, 366-8), and cites not merely Drone as an authority to that effect but also an opinion by Coudert Brothers in the "*Journal de droit international prive*" (vol. for 1876, p. 98, 100, for the same questions arose, under the Act of 1870), and Philipp in "*Bulletin de l'Association litterare et artistique internationale*" (Series II, No. 3, p. 102). *Lyon-Caen et Delalain* in their "*Lois Francaise et Etrangeres sur La Proprietc Litteraire et Artistique*" (Paris, 1889) is to the same effect (vol. II, p. 103, citing Drone and Darras). Kuhlenbeck: Das Urheberrecht (Lepzig, 1901) pp. 319-321 is to the same effect and also Le Droit d'Auteur, (1892, pp. 9, 45). Such was, therefore, till now, the general European understanding of our law.

It is, moreover, an unfounded assumption to regard the omission of the group containing paintings from Sec. 4971 as "accidental" merely, as was done by Judge Brown in Yuengling vs. Schile, *supra*, and such construction runs counter to the decisions of this Court and other federal Courts with respect to other similar variations in this same Act of 1870 (Bate Refrig. Co. vs. Sulzberger, *supra*; Thornton vs. Schreiber, *supra*, and Am. Lith. Co. vs. Werckmeister, 146 F. R., 377 C. C. A., *supra*). The fact is that the International Copyright agitation in the United States which had begun about 1837 when Senator Clay presented his famous report to the Senate in its favor, acquired a new impetus with Dickens' visit to the United States in 1867. In 1868 the American Copyright Associa-

tion was formed, which demanded specifically justice to "artists" as well as authors, by an international copyright law (Putnam, 2d. ed. p. 42). In 1867 the House of Representatives ~~favored a bill~~ directing one of its committees to report on the subject of International Copyright, and in 1868 such report in favor of international protection was submitted (Report H. R. No. 779, Feb. 21, 1868). Meanwhile, as it was known that our copyright laws were being revised, artists petitioned for an inclusion of their works in the law. Senator Sumner presented a petition from Wm. M. Hunt and other Boston artists for such relief on March 8th, 1869 (Cong. Globe 41st Cong., 1st Session, p. 23 and Senate Journal, p. 17), and also a bill to this effect (Id., p. 32). Senator Morgan had done so on Feb. 8th, 1869 already (Cong. Globe, 40th Cong., 3rd Ses., Pt. 2, p. 976), and the National Academy of Design had submitted a petition also (Id., p. 1480). Other N. Y. artists were also memorializing Congress meantime (N. Y. Times, Nov. 2, 1868, Jan. 10, 1869, Feb. 2, 1869). None of the artists asked for a limitation of copyright protection to the United States, and as far as works of art were concerned, international protection was sought by all interested. Hence it is not surprising nor an accident, that the amendment of the law effected by the Act of 1870, by placing works of art on the copyright list, did not limit the same to American productions. Nor was the amendment adopted hastily or without mature consideration. The enumeration of paintings was in the act as reported by Mr. Jenckes from the House Committee on Patents on April 7th, 1870, and was specifically referred to by him (Cong. Globe, 41st Congress, 22nd Session, pp. 2679, 2683, 2854). The Senate Committee introduced the amendment in what is now Sec. 4952 by inserting the word "proprietor" particularly appropriate for the protection of owners of paintings (Id., p. 4822), and the change was carefully considered and

consented to by the Conference Committee of the two houses. The omission of paintings from Sec. 4971 was therefore obviously designed and not accidental.

(i) *But defendant argued below, chiefly on the assumption that Mr. Hernandez's assignment to Mr. Borg passed nothing, because Mr. Hernandez himself could not have secured a copyright under our statutes, under the Act of March 3rd, 1891, because a Peruvian, and such is the reasoning of the Circuit Court of Appeals* (p. 17).

This argument, first of all, overlooks the fact that this supposed disability of alienage is a personal one, which Congress of course could, and doubtless intended, to abolish, as various States have done as to realty, in favor of the acquisition of such property rights by a citizen of the United States or of a country with which we have copyright relations. Even the most familiar examples of this disability, an alien's lack of capacity to own land, was cured by assignment or descent from the alien, even at common law (Manuel vs. Wulff, 152 U. S., 505; U. S. vs. Southern Pacific R. Co., 88 Fed. Rep., 832; Am. & Eng. Ency. of Law, (2nd Ed.), Vol. II, pp. 70-72.

In the light of the laws of foreign countries and the Berne convention, which were carefully studied by the law-makers, it seems obvious that the removal of such disability by assignment was expressly intended by Congress in this International Copyright Act, just as had been done in terms in foreign countries, where the limitation to native "authors" had been abolished.

The language of our copyright law is, we submit unmistakable and unambiguous in making right to copyright turn simply on the citizenship of the person taking out the copyright.

(j) *But it is fallacy to say that Mr. Hernandez's assignment to plaintiff passed nothing.* It is perfectly well established by a practically unanimous line of State and federal decisions that Mr. Bong, before he sought his federal copyright, and published the paint-

ing under those limitations in photogravure reproductions, could have enjoined defendant's infringement as a violation of his "common-law copyright rights," and in the federal court, at that, because of jurisdiction based on his alienage. The Copyright Act in exchange for publication, gave him a statutory copyright for a limited period, upon compliance with its terms.

The common law copyright rights, before publication, of the painter or owner of a painting or other copyrightable objects, are of course well established.

Werckmeister vs. Am. Lith. Co., 134 F. R., 321 (CCA); aff. 207 U. S., 284.
Parton vs. Prang, 3 Cliff., 537, 18 Fed. Cases, 10,784.
Werckmeister vs. Am. Lith. Co., 142 F. R., 827; Aff., 146 Fed. Rep., 377.
Turner vs. Robinson, 10 Ir. Ch. Rep., 121, 510.
Oertel vs. Wood, 40 How. Pr., 10.
Prince Albert vs. Strange, 2 De Gex & Smale, 652.
Press Pub. Co. vs. Monroe, 73 Fed. Rep., 196, (CCA), appeal dismissed, 164 U. S., 105.
Palmer vs. DeWitt, 47 Fed. Rep., 532.
Thomas vs. Lennon, 14 Fed. Rep., 849.
Iolanthe Case, 15 Fed. Rep., 439.
Mikado Case, 25 Fed. Rep., 183.
Globe Co. vs. Walker, 210 U. S., 356.

See also Mansell vs. Valley Printing Co. (1908) 1 Chanc., 198, Aff. (1908); 2 Ch., 441, in which the English Court has just held that as to paintings, the common law copyright subsisted until publication, unlike printed books.

This rule of law as to common law copyright is not limited in any way under the American authorities, to productions by American authors or painters. The rule is well laid down in the

Am. & Eng. Ency. of Law, (2nd Ed.), Vol. VII, p. 519:

"Since an author's property in his unpublished works stands upon precisely the same basis as property of any other description, the protection afforded by the common law to intellectual productions is accorded to alien friend and citizen alike;" citing:

Palmer vs. De Witt, 47 N. Y., 532.
Crowe vs. Aiken, 2 Bliss., 208, 6 Fed. Cases, 3,141.
Keene vs. Wheatly, 4 Phil., 157, 14 Fed. Cases, 7,644.
Thomas vs. Lennon, 14 Fed. Rep., 849.
Tompkins vs. Halleck, 133 Mass., 32.
French vs. Maguire, 55 How. Pr., 471.
Shook vs. Daly, 49 How. Pr., 366.

Said the New York Court of Appeals in the leading case of *Palmer vs. DeWitt, supra*, involving common law copyright in a play, by a foreign playwright of London, and which case was cited with approval in Press Pub. Co. vs. Munroe, *supra*, and nearly all the other federal cases cited:

"Real property is governed by the *lex loci rei sitæ*, and an alien can only acquire and hold title as permitted by the local law. But not so as to personalty. In Calvin's case, (7 Co., R. 17a), it was held that an alien friend may, by the common law, have, acquire and get within the realm by gift, trade or other lawful means, any treasure or goods personal whatsoever as well as any Englishman, and may maintain action for the same. This has always been accepted as the common law of the United States. An alien friend may resort to the tribunals of this State for the prosecution of any right recognized by our laws, or the redress of any wrong cognizable by our courts. *The right to literary property is as sacred as that*

to any other species of property. The courts of the State are open to an alien friend pursuing his property, and seeking to recover it from a wrongdoer; and *there is nothing in any positive law or in the policy of the government, which would close the door against the same alien friend seeking protection for the fruits of his mental labor, by restraining its publication against his wishes. The protection afforded by the common law to literary labor is very slight at the best, but such as it is, it is accorded to alien friend and citizen alike, and both are regarded with equal favor * * * The rights of assignees domiciled here, of alien authors resident abroad have been sustained by the courts of this country and no distinction has been made between transfers of literary property and property of any other description."*

In the Werckmeister case (134 Fed. Rep., 320), the Circuit Court of Appeals and this Court conclusively showed that paintings stand on the same footing as manuscripts, as also do the English Courts in the recent case of Mansell vs. Valley Printing Co., *supra.*

(k) The learned trial Judge, however seems to have thought that resort to the English common law rule, was necessary (p. 10). Of course this was only on the theory that our statute did not make specific provision, which, we submit, it does unmistakably. Why the English common law should be resorted to for the purpose of reading into the statute, unexpressed conditions and limitations, as to a matter expressly governing other foreign nations as well and which was here the subject of a convention with Germany, and had been regulated in England by treaties and statutes changing the alleged common law rule, is not apparent. There is, however, a well established common law of the United States on this subject, as just seen, expounded in the American cases cited,

State and Federal. Under those circumstances, it is obviously unsatisfactory to resort to certain English cases inconsistent with their own earlier decisions, as well as our own, and decided largely because our own country was denying statutory copyright to them, leading them to pass more restricted statutes, and the Courts have specifically emphasized the inapplicability of English cases on copyright in paintings in Werckmeister vs. Pierce Co., 63 Fed. Rep., 445 at 448, which was specifically approved in Werckmeister vs. Am. Lithographic Co. (146 F. R., 375).

Until 1845 there was an unbroken line of English cases, holding that foreign citizenship and foreign residence were no bar to an English copyright:

D'Almaine vs. Boosey, 1 Y. & Coll., 288 (Lord Lyndhurst).
Bentley vs. Foster, 10 Simon, 329.
Guichard vs. Mori, 9 Law Journal Chan., 227.
Bach vs. Longman, 2 Cowp., 623.

In Chappel vs. Purday, 14 M. & W., 303, decided in 1845 by the Court of Exchequer, it was first intimated that a non-resident alien could not acquire an English copyright. The Court of Common Pleas, in 1848, repudiated this holding, and followed the earlier cases, in Cocks vs. Purday, 5 C. B., 860, as did also the Court of Queens Bench, in 1849, in Boosey vs. Davidson, 13 Ad. & Ellis, N. S., 257, and the Court of Chancery in 1850 and 1851, respectively, in Olendorff vs. Black, 4 De G. & Sm., 209 and Buxton vs. James, 5 De G. & Sm., 80.

As the Court of Exchequer reaffirmed its holding to the contrary, its decision in Boosey vs. Jefferys, was taken up on appeal and overruled by the Exchequer Chamber in 1859, reported as, 6 Exchequer, 580, but the House of Lords reversed in a case involving books merely, reported as

Jefferys vs. Boosey, 4 H. L. Cas., 815, in 1854.

In the later case of Routledge vs. Law L. R., 3 H. L., 100, decided in 1868, the correctness of the decision in Jefferys vs. Boosey was questioned by Lords Cairne and Westbury, but special statutes and constitutions and the Berne Treaty have made the question an academic one merely for England, as noted *ante* (pp. 13-14).

In Palmer vs. De Witt, 47 N. Y., 532, 540, the New York Court of Appeals expressly disapproved of the House of Lords' decision in Jefferys v. Boosey, and pointed out that it was inconsistent with the views of six of the ten judges of the law courts, to whom the question had been submitted, and that its authority was questioned by the House of Lords in Routledge vs. Law, *supra*. The line of cases represented by Palmer vs. De Witt is correct, it is submitted, on principle and by the great weight of authority, and has been quite uniformly adopted in America in the State and federal courts, as shown in the cases already cited. Moreover, Jefferys vs. Boosey involved the construction simply of the English statute of Anne as to copyright in books, and was complicated by the fact that the foreign assignor had first taken out a copyright in his own country.

Before dismissing this question it should be noticed that the English foreign office in 1891, obtained the advice of the government law officers in order to inform our government officially as to the English law in connection with our act of March 3rd, 1891, and then Lord Salisbury made the following written statement to our minister on June 20th, 1891:

> "Her Majesty's Government are advised that under existing law an alien by first publication in any part of Her Majesty's Dominions, can obtain the benefit of English copyright and that contemporaneous publications in a foreign country does not prevent the author from obtaining English copyright, and that residence in

some parts of Her Majesty's dominions is not a necessary condition to an alien obtaining copyright under the English copyright law" (Moore's Intern. Law Digest, II, p. 51).

POINT II.

The convention with Germany referred to in the President's Proclamation, specified in the complaint, requires a liberal construction in favor of the German assignee's rights.

The complaint refers to the President's Proclamation as to Germany, under Section 13 of the Act of 1891 (27 Stat., at L. pp. 1021-2), and that sets up in full the terms of a convention with Germany, entered into January 15th, 1892, on the subject, pursuant to which it was provided:

> "Article I. *Citizens of the United States of* America shall enjoy, in the German Empire, the protection of copyright as regards works of literature and art, as well as photographs, against illegal reproduction, *on the same basis on which such protection is granted to subjects of the Empire.*"
>
> "Article II. The United States Government engages in return, that the President of the United States shall, in pursuance of section 13 of the Act of Congress of March 3rd, 1891, issue the proclamation therein provided for *in regard to the extension of the provisions of that Act to German subjects* as soon as the Secretary of State shall have been officially notified that the present agreement has received the necessary legislative sanction in the German Empire."

As recited in the President's Proclamation of April 15th, 1892, as to Germany, that country made the necessary changes in her laws, and gave the requisite notice to the secretary of state, whereupon the president issued his proclamation as to Germany, and in reliance upon it, the plaintiff surrendered his common law copyright, in order to secure a statutory one by complying with the Act of Congress as to copyrights.

The principle of law is of course well settled, that treaties and conventions should be construed most liberally, so as to preserve international faith and good will, and our statutes be construed in aid of them. Said this Court in Tucker vs. Alexandroff, 183 U. S., 424, 437:

> "As treaties are solemn engagements entered into between independent nations for the common advancement of their interests and the interests of civilization, and as their main object is not only to avoid war and secure a lasting and perpetual peace, but to promote a friendly feeling between the peoples of the two countries, they should be interpreted in that broad and liberal spirit which is calculated to make for the existence of perpetual amity so far as it can be done without the sacrifice of individual rights or those principles of personal liberty which lie at the foundation of our jurisprudence."

It would be most unfair and unreasonable to limit our statutes by unexpressed conditions and restrictions by judicial construction to defeat valuable rights created on the faith thereof. In Merriam Co. vs. United Dictionary Co., 146 Fed. R., 354 (CCA.) the Circuit Court of Appeals held in the 7th Circuit that even authorized publication abroad without our copyright imprint does not avoid American copyright, a view since approved by this Court in United Dictionary Co. vs. Merriam Co., 208 U. S., 260.

The European courts dealing with copyright have accorded the most liberal possible construction to foreign copyrights. In Osgood vs. Blumenfeld Matthews (LeDroit d'Auteur, 98, p. 45-9 and summarized in Briggs, p. 522) the Imperial Court of Germany, reversing the lower court, held that a work written by an American author, to wit, Gen. Wallace's "Prince of India" and published in the United States and simultaneously in Great Britain by plaintiff under a grant of exclusive selling rights for England is to be regarded as an English work entitled to protection under the Berne Convention in all union countries, despite the American publication and authorship, and a German translation was enjoined. Similarly, the Tribunal of Commerce of the Seine has just made a similar ruling with respect to a Russian work, published in Germany, reprinting of which was enjoined in France (see *Le Droit l'Auteur*, the official organ of the International Copyright Union, 1908, pp. 5-7, in the case of Persky vs. Jovea).

In England the Appellate Court has just held, after some division of opinion below, that a foreign work entitled to protection under the Berne International Convention, need not be imprinted, registered or filed as required of English works, provided the forms prescribed by the country of origin were complied with (Sarpy vs. Holland (1908) 2 Ch., 198). All these authorities sustain Briggs' claim (pp. 119-120, 146-7) that international copyright arrangements should be most liberally construed and enforced.

On the other hand, as already stated, Germany granted the United States most liberal concessions by changing her own domestic laws in our favor, in making the Copyright Convention of 1892 with us (Briggs, pp. 663-5). The convention was entered into despite bitter assaults upon it in the German Parliament, with respect to America's unfair attitude. As Briggs says concisely: "The general opinion was that Germany gave with both hands only to receive a very slight re-

turn." The opposition in the Reichstag (*Le Droit d'Auteur* 1892, pp. 9, 45; 1893, p. 121), was since vehemently renewed with a demand for diplomatic representation on the subject, on the occasion of Germany's further liberalizing her own law as to works of art and photographs (*Id.*, 1894, p. 111, 1906, pp. 25, 52, 159). As already pointed out, in addition to international protection by treaties and the Berne Union, the German law of 1870 gave copyright protection not merely to all German authors and artists but also to all works first published in Germany. As to books, and musical and dramatic works, this was extended in 1891 so as to protect all works of aliens not previously published elsewhere (Briggs, pp. 65-7, 203-4, 663); *Recueil des Conventions et Traites concernant la Propriete Litteraire et Artistique*, Berne, 1904, pp. 45-55). By a law of Jan. 9th, 1907, as to copyright in works of art and photography (*Schlittgen: Das Urheberrecht*, 1908, Sec. 51): "Copyright protection is enjoyed by all subjects of the Empire for all their works whether published or unpublished and persons not subjects of the Empire, enjoy this protection for their works, which are published within the Empire, provided that they have not been previously published abroad." Under the Convention of 1892 the United States obtained all these privileges, free from our "printed-first-in the United-States" provisions. During the whole history of the Empire as seen, not merely works by Germans but also foreign works published in Germany, were protected, and Germans have understood our statute as giving them protection for all works of which they are authors or proprietors or assigns, whatever the citizenship of the author. As paintings, musical compositions and engravings have not been limited by our "original printing in the United States" provision (Littleton vs. Ditson Co., 62 F. R., 597 CCA.) these articles have been substantially the only ones enjoying protection

under the Convention of 1892. By the construction of the lower courts, this protection would be seriously curtailed by judicial construction and reading in of unexpressed terms, and much German and other foreign capital invested in such copyright assignments and their development would be made valueless. It is submitted that defendant's construction is inadmissible and unfair.

POINT III.

The Court below erred in holding that the statute involved declares a penalty "which is a very noxious thing," and requires a strict construction designed to avoid it, if possible.

See Judge Hough's opinion (pp. 10-11; duly excepted to, p. 11).

Judge Hough was here dealing with provisions for securing copyright, which lie at the bottom of all suits, legal or equitable, under our copyright laws, and not with the penalty provisions. In thus applying in extreme form, the rule that penal statutes are to be strictly construed, it is submitted that the Court overlooked the fact that this principle has no application to the provisions of law conferring copyright, as distinguished from those declaring its penal provisions. If an equity suit for injunction and an accounting had been brought, the questions here involved would have been clearly the same, and the Courts cannot find that a copyright is valid for purposes of an injunction, and void as to an action for the penalty. (Compare Atlanta vs. Chattanooga Foundry, 127 F. R., 231 C. C. A.). The rule of law as to validity of copyrights is correctly expressed, it is submitted, to the contrary in Judge Holt's opinion in

Werckmeister vs. Am. Lith. Co., 142 F. R., 827:

"The object of the copyright law is beneficient. It was intended, in the language of the Constitution 'to promote the progress of science and useful arts,' and, in my opinion, the copyright laws should be liberally construed to carry out the intention of the Constitution."

See acc. Myers vs. Callaghan, 5 Fed. Rep., 726, 20 Fed. Rep., 441.
Bleistein vs. Donaldson, 188 U. S., 239.

(b) But even if the construction of the penal provision itself were here involved, it would be erroneous, it is submitted, for the Court to instruct the jury that a penalty "is a very noxious thing." With such instructions, it is submitted, a jury cannot be reasonably expected to do its share in enforcing the Act of Congress. Even aside from the fact that Section 4965 of the copyright laws is remedial, as well as penal, such instruction to the jury goes far beyond declaring the usual principle, applicable to all statutes prescribing penal or criminal remedies, that they should be strictly, though reasonably, construed. In construing the penal provisions of Section 4965 as amended, the Court said in

Bolles vs. Outing Co., 175 U. S., 262, 265:

"The statute, then, being penal, must be construed with such strictness as to carefully safeguard the rights of the defendant and *at the same time preserve the obvious intention of the legislature. If the language be plain, it will be construed as it reads, and the words of the statute given their full meaning;* if ambiguous, the court will lean more strongly in favor of the defendant than it would if the statute were remedial. *In both cases it will endeavor*

to effect substantial justice. United States v. Hartwell, 6 Wall., 385; United States v. Wiltberger, 5 Wheat., 76, 95; American Fur Co. v. United States, 2 Pet., 358; United States v. Reese, 92 U. S., 214."

Judge Hough's direction went far beyond this principle, and on a retrial, would be apt to improperly influence the jury in its determination.

See

U. S. vs. One Pearl Necklace, 111 F. R., 164, 172 (CCA).

In fact, it has been repeatedly held in this district that such actions for penalties under the copyright laws are not subject to the rule that the case must be established beyond a reasonable doubt, for instance; compare

U. S. vs. Shapleigh, 54 Fed. Rep., 126 (CCA).
Atlanta vs. Chattanooga Foundry, 127 F. R., 23 (CCA).

POINT IV.

The Court's argument below that because colorable assignments might be resorted to, the statute shold be construed to deny copyright to works produced by citizens of countries outside the President's copyright proclamation, is untenable.

The Trial Court below used this argument (p. 11), though of couse it could not be assumed that the assignment to plaintiff was colorable merely. Even on the papers before the Court, it appeared that plaintiff paid a monetary consideration for his grant, and at

his own instance and for his own account, was making photogravure reproductions of the paintings at great expense. In fact, at the time of copyrighting, Signor Hernandez had no rights in the painting nor to reproduce it.

Even if a colorable assignment could be disregarded and ignored, it is therefore obvious that on plaintiff's opening, concededly not containing the remostest suggestion of a concession that the assignment was merely colorable, the Court could not say that because an assignment might be colorable, all assignments are to be disregarded.

In fact, it is submitted that the *rule of law applicable to realty owned by aliens applies, and that a transfer eliminates the disability* (see authorities cited *supra*).

But even under our Copyright Laws before 1891, when foreign books were first permitted to be copyrighted, efforts to avoid assignments made to accord with our statutes, on the ground that they might be colorable, regularly proved unsuccessful.

> Carte vs. Evans, 27 Fed. Rep., 861.
> Black vs. Allen Co., 42 Fed. Rep., 618, 620-1, (Shipman, J.).

Said the Court in Carte vs. Evans, *supra*:

> "Tracy's work was done with the consent of the original composers of the opera, and in their interest. There is nothing in our copyright law to prevent one of our own citizens from taking out a copyright of an original work composed by him, even though the work of composition was performed at the procurement and in the employment of an alien; or from assigning his copyright to an alien under an agreement made either before or after the composing of the work. A non-resident foreigner is not within our copyright law, but he may take and hold by assignment a copyright grant-

ed to one of our own citizens. The proprietor as well as the author is entitled to enter the work for copyright. The consent of Tracy was sufficient to constitute Browne the proprietor for the purpose, without a formal assignment. *Lawrence v. Dana*, 4 Cliff., 1, 65. The effect of the transaction was the same as if Tracy had made the entry in his own name, and then assigned to Carte.

"The defendants insist that the method of proceeding by which the copyright was procured, and afterwards vested in the plaintiff, a non-resident foreigner, was a mere evasion of our copyright act, and as such is not entitled to the protection of the court. But I am unable to perceive how it can properly be called an evasion, if by that is meant a proceeding by which the letter or spirit of the law is directly or indirectly violated. The thing copyrighted was an original work, by an American composer, and therefore the lawful subject of copyright. All the steps taken to secure the copyright, and vest it in the plaintiff, were authorized by our statute. Undoubtedly the plan adopted displayed great ingenuity, and the effect is to vest in these foreign authors valuable American rights in their work; but there is nothing of evasion or violation of law. The plaintiff is therefore entitled to the protection of the court against infringers, if his copyright is otherwise valid."

As already seen (*ante*, p. 15-18), the English statute even permits foreigners to take out copyrights in the names of native publishers, whatever their own private arrangements among themselves may be. Similarly, in view of the trouble, delay and expense attending proving citizenship of author or proprietor or both, the Berne Convention specifically provided (Art. 11):

"In order that the author of works protected by the present Convention may, in the absence of proof to the contrary, be considered as such, and consequently admitted to install proceedings against infringements before the courts of the various countries of the Union, it is sufficient for their name to be indicated on the work in the accustomed manner. For anonymous or psuedonymous works the publisher whose name is indicated on the work is entitled to safeguard the rights belonging to the author. *He is without further proof reputed the lawful representative of the anonymous or psuedonymous author.* It is understood nevertheless, that the court may, if necessary, require the production of a certificate from the competent authority stating that the formalities prescribed, according to Article 2 by the law of the country of origin, have been fulfilled."

Our courts have also recognized that the certificate of copyright *prima facie* establishes title (Reed vs. Carusi, 20 Fed. Cases, 11, 642, Taney Ch. J.; Callaghan vs. Myers, 128 U. S., 617, 655).

POINT V.

The direction of a verdict was not based, nor is it sustainable, on the theory that plaintiff, apart from the alienage question, had no copyrightable interest in the painting.

Judge Hough's Opinion, on disposing of the case, clearly shows that he decided it solely on the question as to the right of a German assign of a Peruvian artist to take out a copyright; to avoid any mistake on the point, as counsel's opening had not been taken down (page 9), he even reiterated the facts stated in the opening which he relied upon (page 10). When

the Bill of Exceptions, however, was prepared, he inserted therein, at the request of defendant, a reference to certain writings exchanged between Hernandez and Bong (p. 9), having no apparent bearings on this point. They show that Hernandez executed to Bong a transfer of all American copyright rights in this painting "Dolce far niente," also known as "Sweetly Dreaming," and also granted to him an exclusive license for Europe as well, covering certain forms of reproduction. It did not appear on the trial, and was not gone into there, whether Bong acquired further rights or not, or whether Hernandez had or had not parted with his European rights of reproduction in other forms before the American copyright was taken out, in favor of a subject of a country within the "President's Proclamations," or reserved some (European) rights himself. However, defendant's insistence in the direction of including these writings in the Bill of Exceptions, indicates that it wants to argue upon their basis, as it did in the Circuit Court of Appeals where, however, that question was not considered on the merits (p. 17). As shown hereinbefore, the fact is that at the time of copyrighting, all rights in and to the printing belonged to German subjects (*ante*, p. 9). But when we consider the question on the merits we submit that plaintiff's rights are not impaired by the reservation of rights appearing in the grants to him, which included an absolute right to secure American copyright rights.

It is now well settled that a transfer of common law copyright in a painting entitled the transferee to take out a copyright, though he does not own the physical painting, but the question was still doubtful when this case was tried below.

> Am. Tobacco Co. vs. Werckmeister, 207 U. S., 284, 296-9; aff., 146 F. R., 375.

Surely an assign of the American copyright rights is entitled in his own behalf to copyright the painting.

(Same case and cases there cited.)
Goldmark vs. Kreling, 35 Fed. Rep., 651.
Merriam Co. vs. United Dictionary Co., 146 Fed. Rep., 354 (CCA).
Werckmeister vs. Springer Co., 63 F. R., 808 (Townsend, J.).
Palmer vs. De Witt, 47 N. Y., 541.

Such is the usual course with respect to transfer of American rights. Even if the copyright were held in part by him for the benefit of persons other than plaintiff, he would be entitled to take out the copyright in his own name.

Press Pub. Co. vs. Folk, 59 Fed. Rep., 324.
Lawrence vs. Dana, 4 Cliff., 15 Fed. Cases, 8136.
Wooster vs. Crane, 147 Fed. Rep., 515, (CCA).
Goldmark vs. Kreling, 35 Fed. Rep., 661.
Am. & Eng. Ency. of Law (2nd Ed.) Vol. VII, pp. 545-6.
Mifflin vs. White Co., 190 U. S., 260.
Ford vs. Blaney Co., 148 Fed. Rep., 642 (Holt, J.).
Harper vs. Donohue & Co., 144 F. R., 491, 494.
Osgood, McIlvaine & Co. vs. Felsenheld (Imperial Court of Germany), considered *ante*, p. 55).

The last cited case is instructive as showing how usual transfers of limited rights of publication and sale for a particular country are, and how the Courts, under the Berne Convention, give them effect, in order to secure simultaneous international publication and protection.

POINT VI.

The construction placed by the State Department on Section 13 of the Act of March 3rd, 1891, is erroneous, and even Hernandez, as a subject of Peru, which country belongs to the Montevideo International Copyright Union, was entitled to a statutory copyright in his own right.

Incidental reference has already been made (p. 18, *ante*) to the opinion of Assistant Secretary of State Moore, in 1891, reported in his International Law Digest, II, Sec. 182, and followed ever since by the Executive, under which countries belonging to the Berne and Montevideo International Copyright Unions have been denied copyright protection, though the United States is free "at its pleasure" to join these unions, because the quoted words in Section 13 of the Act of March 3rd, 1891, were construed as meaning that such joining must be permitted without change in our own laws. The Berne Copyright Union provided (Article 18, Briggs, p. 248). "Countries which have not become parties to the present Convention if they assure in their own territory legal protection to the rights which form the object of this Convention shall be permitted to accede thereto upon their request. The accession shall be notified in writing to the government of the Swiss Confederation and by the latter to the others. It shall imply as a necessary consequence adhesion to all the clauses and admission to all the advantages stipulated for in the present Convention."

As the United States by actually joining would have obliged itself to abandon its type-setting provision, which was a curtailment not recognized by the Berne Convention, it was now claimed that it was not even free "at its pleasure" to join. The provisions of the Montevideo Union are even broader in form as to

joining, though similar in effect (Briggs, pp. 699-702). Articles 3 and 16 read as follows:

> "Art. 13: It is not indispensible for the putting into force of this treaty that its ratification on the part of the Signatory States shall be simultaneous. Every state that approves it shall notify the fact to the government of the Argentine Republic and the Republic of Uruguay, in order that they may bring it to the notice of the other contracting nations. This procedure shall serve as an exchange of ratifications."

Art. 16 provides:

> "Article 13 may be extended to States not having taken part in the present Conference which wish to adhere to the present treaty."

Under article 1 and 2 each State is obliged to accord to an author of a literary or artistic work "or his successors" the rights accorded to him by the law of the place of first publication or production.

Peru joined this Union in 1888 (Briggs, p. 466).

It is submitted that this departmental construction is erroneous. The statute does not provide that the United States must first join such union, but merely that it must be able, "at its pleasure," to become a party thereto. *Both of these unions were specifically referred to in the Simond's Report to Congress which accompanied this very bill, and the language in question was clearly used with reference to including them ipso facto.* Under the statute the President was not authorized at his own say-so, to have the United States join such union, and legislation either by Congress or by the treaty-making power, was in any event requisite, before the United States could signify its intention of joining "at its pleasure." This in itself would involve a change in our own laws, therefore, all the

statute required was that at its pleasure it might join. *The State Department's construction simply struck these words out of the Statute.*

It is not surprising that Prof. Moore should have doubted the correctness of his own construction, for he says in his opinion that this branch of the statute as to international agreements "has given rise to much discussion and to variant interpretations."

The statute seems clearly designed to meet the then existing situation, the existence of two international copyright unions which the United States was free to join if the law or treaty—making power so provided, but meantime extended to the countries belonging to such unions such limited copyright protection as our own laws provided. If the United States actually lawfully joined these Unions, such municipal legislation by Congress would have been unnecessary. The purpose to accord copyright protection to all countries belonging to these unions seems perfectly clear. As already noted, Pres. Cleveland had officially communicated the proceedings of the Berne Copyright Union to Congress in 1885 and 1886 and they were duly published (ante, p. 14). The proceedings of the Montevideo Copyright Union were submitted by Pres. Harrison with a message dated July 11th, 1890, and published in Senate Ex. Document No. 177, 51st Congress, 1st Session. Pres. Cleveland had stated in his annual message of Dec. 6, 1886, (Moore's Dig. Vol. II, Sec. 182): "The right of adhesion to the Berne Convention hereafter has been reserved. I trust the subject will receive at your hands the attention it deserves and that the just claims of authors, so urgently pressed, will be duly heeded." Pres. Harrison's message of Dec. 3, 1889 contained a similar passage. In the Report of Mr. Simonds, as chairman of the House Committee, in reporting this bill on June 10, 1890 (Putnam: The Question of Copyrights, pp. 181-3) he referred at length to these International Conventions. The obvious purpose of the Act of March 3rd,

1891, was to extend protection to the countries of these unions, while reserving our own policy of protection to domestic type-setters and engravers. Until Prof. Moore's opinion was handed down, which has never been considered before in any court, it was believed that the Act had this effect, besides making provision also for other countries affording reciprocal copyright protection. In its opinion in White Smith Co. vs. Appollo Co., 209 U. S., 1, 14-15, after quoting the terms of Section 13 and noting that all the proclaimed countries specified belonged to the Berne Union, this Court evidently regarded this statute as conferring such protection by its terms on the countries of the Berne Union. Prof. Moore's construction simply eliminated these words from the statute. Mr. Briggs in his work on International Copyright (pp. 248-9) in line with numerous foreign writers, have criticised Prof. Moore's opinion as incorrect. He says:

> "The United States, however, when considering whether Sec. 13 of the Chance Act of 1891 authorized it to admit the countries of the Union *en bloc* to the benefit of that Act seems to have been under the impression that in view of the existence of the type-setters clause in the Act, Art. 18 of the Convention debarred it from adhering thereto at its pleasure. The United States may have been quite right in holding that it could not thus accept the Convention, but if so *this was not because Art. 18 did not give it permission to accede to the Union at will.* It was a consequence of the fact that for the United States to take advantage of that permission would be for it to pledge itself to an extension of its domestic protection which it was unable to carry out."

It is true that counsel for plaintiff-in-error, as a matter of argument, conceded in opening the case for the jury below that the case might be regarded as if Hern-

andez's citizenship were immaterial (page 10), in view of the fact that the President has issued no proclamation as to Peru, though objection was made to disposing of the case on this concession merely (p. 10). Counsel had in mind the decision of the Circuit Court in a somewhat analogous case in DeLima vs. U. S. (Townsend, J., unreported), following Field vs. Clark, 143 U. S., 649, 680, *et seq.*, holding that under the Customs Reciprocity provisions, an inquiry is inadmissible to determine whether the President found the requisite facts, where his finding was not expressed in the form of a proclamation. *A more careful examination of the Copyright Law provision indicates, however, that here, copyright protection is accorded when the fact exists, and the President's proclamation, specified in an independent sentence, is merely made a convenient, directory, manner of proclaiming and proving the fact. An erroneous failure to issue the proclamation does not prevent copyright from vesting, as the legislative will cannot thus be disregarded.*

> Morrill vs. Jones, 106 U. S., 466.
> Campbell vs. U. S., 107 U. S., 407, 410.
> U. S. vs. Dominci, 78 Fed. Rep., 334 (CCA).
> Butterfield vs. Stranahan, 192 U. S., 470, 496.
> Williamson vs. U. S., 207 U. S., 425, 461-2.

Such also seemed to have been the view of the Senate as to this very provision, as indicated by the remarks of Senators Edmunds, Hoar, Morgan and Allison in the debate in the Senate (Cong. Record, Vol. 22, pp 2607-8, 2675-6, 2793, 2834). Moreover, as already noted, various countries which afford even absolute equality of rights as to copyright to foreigners and aliens alike, have been omitted from the President's proclamations (Briggs, 2nd, pp. 659-660). As Peru is embraced by the provisions of Sec. 13 of the Act of 1891 as a member of the Montevideo Union, a mistrial took place below in this case.

POINT VII.

The Court erred in dismissing the complaint on the opening of counsel, against plaintiff's objections.

The Record shows that the Court directed a verdict for defendant on counsel's opening, on the citizenship point, following the practice considered in

> Oscanyan vs. Winchester Arms Co., 103 U. S., 261,

despite counsel's request to proceed, and though the opening was not taken down.

That case itself refers to the dangers of such a course, and these have been emphasized in several recent New York cases (Hoffman House vs. Foote, 172 N. Y., 348; Kennedy vs. White, 91 App. Div., 475) and in Barber vs. Connolly, 113 U. S., 27, 37; Van Slone vs. Stillwell Co., 142 U. S., 128, 134; Butler vs. National Home, 144 U. S., 64, 72-3. Said the N. Y. Court of Appeals in Hoffman House vs. Foote, *supra*:

> "When a defendant demands and procures such a ruling at the trial he must be prepared to defend it in this Court upon the assumption that every material fact in issue is to be resolved or found in favor of the plaintiff * * * The practice of disposing of cases upon the mere opening of counsel is generally a very unsafe method of deciding controversies where there is or ever was anything to decide. It cannot be resorted to in many cases with justice to the parties unless the counsel stating the case to the jury deliberately and intentionally states or admits some fact that, in any view of the case, is fatal to the action."

Even as far as the citizenship question is concerned, it is apparent that this concession was not made with a view to authorizing a dismissal of the complaint on the opening, and counsel has since seen "more light." than he had at the time he made this concession on a pure question of law. If, moreover, it is now sought to sustain this decision, without evidence, on other grounds than the Trial Court adopted, it is submitted that the method of trial below is inconsistent with such right. The Circuit Court of Appeals evidently fell into error on this question of practice, as indicated by its comment (p. 17): "For aught that appears the painting still belongs to Hernandez." Plaintiff in error is, of course, on this state of the record, entitled to the most favorable inferences justified by his complaint, and specific reference has been made in this brief (p. 9), as authorized under Osconyan vs. Winchester Arms Co., *supra*, to the evidence available at the trial in the shape of Mr. Hernandez's deposition as a witness for defendant, showing that before the copyright was obtained he sold the painting to a German subject reserving the copyright rights, assigned the right to take out American copyright to plaintiff, and granted him sole right of reproduction everywhere except by photography and monochrome processes, and simultaneously granted to another German subject these reserved rights. All rights were therefore vested in German subjects, when the copyright was taken out by plaintiff for the protection of all persons concerned, including himself. Nor was the trial a "satisfactory" one, so this Court should exercise the right to order a new trial, as it did in U. S. vs. Rio Grande Co., 184 U. S., 416.

POINT VIII.

The judgment should be reversed, with costs.

Respectfully submitted,

MAX J. KOHLER,
of Counsel for Plaintiff-in-Error.

Office Supreme Court, U. S.
FILED.
MAR 30 1909
JAMES H. McKENNEY,
CLERK.

20

Supreme Court of the United States.

No. 150.

RICHARD BONG,
Plaintiff in Error
(Plaintiff below),

against

THE ALFRED S. CAMPBELL ART COMPANY,
Defendant in Error
(Defendant below).

BRIEF OF DEFENDANT IN ERROR.

GEORGE KYALL,
Of Counsel for Defendant in Error.

The Evening Post Job Printing Office, 154 Fulton St., N. Y.

The Evening Post Job Printing Office, 156 Fulton St., N. Y.

Supreme Court of the United States.

RICHARD BONG,
Plaintiff in Error,

AGAINST

THE ALFRED S. CAMPBELL ART COMPANY,
Defendant in Error.

BRIEF FOR DEFENDANT IN ERROR.

This is a writ of error in a copyright case to review the judgment of the United States Circuit Court of Appeals for the Second Circuit, affirming the judgment of the Circuit Court for the Southern District of New York. The Court directed a verdict for the defendant *mainly on admissions by the attorney for the plaintiff below.*

This action was brought by plaintiff in error to recover penalties and forfeitures to the amount of $10,000, under Section 4965, as amended, of the Revised Statutes, for infringement of an alleged copyright. Upon the trial the Court, *upon plaintiff's opening, and documents then submitted*, directed a verdict for the defendant. The complaint alleges that Bong, the plaintiff, is and at all times was a citizen and subject of the German Empire, a country whose citizens may obtain copyrights in this country; that in or about 1899 one Daniel Hernan-

dez painted a picture, of which he is the author, inventor and designer, called "*Dolce far Niente*," that the said Hernandez was then and has always since been *a citizen and subject of Spain*, a country whose citizens may obtain copyrights in this country, and that prior to November 8, 1902, *the plaintiff became the lawful and sole proprietor of said painting by due assignment*, pursuant to law, and obtained a copyright on said painting.

Upon the opening the plaintiff's attorney admitted:

(*a*) That the plaintiff never owned the painting (fol. 43).

(*b*) That he would offer no evidence to establish the citizenship of Hernandez, *and would not controvert the statement made on behalf of the defense that Hernandez is and always has been a citizen of Peru* (fols. 46–47).

(*c*) That the rights which Bong had in the painting were obtained from the author by the following assignments (fols. 44–46), *which by consent of counsel for both parties were submitted to the Court:*

> "The undersigned hereby authorizes Mr. Richard Bong, Berlin, W. 57 Potsdamer Street, 88, and conveys to him the right to enter his painting 'Sweetly Dreaming' for copyright protection in America, viz., in the Copyright Register in Washington, to enter the same in his own name as proprietor, as well as to take any steps in his own name necessary for the securing and protection of said right.
>
> Paris, June 1, 1902.
>
> (Signed) DANIEL HERNANDEZ."

> "I, the undersigned, D. Hernandez, artist, painter, living at 235 Fauborg St. Honore, declare by these presents to cede to Messrs. Bong & Co. the exclusive right of reproduction, in colors and in all kinds, and also the exclusive right of engraving, etching, lithog-

raphy in black and in colors, in consideration of the sum of 500 francs, which I have this day received, and for which I hereby give receipt."

Paris, July 7, 1902.

Received payment,

DANIEL HERNANDEZ.

Revenue Stamp.
Marked cancelled
July 7, 1902.
D. H.

P. S.—It is well understood that the right of photography and reproduction by all photographic monochrome processes is not herein included."

Certain documents are alleged in his brief by the plaintiff in error to be on file in the Circuit Court which would show the ownership of the painting to be in a citizen of Germany. It is not permissible to argue from such papers, as they were not before the Circuit Court.

POINT I.

Hernandez, being a citizen and subject of Peru, could not have obtained a copyright in this country, and most assuredly he could not assign a right which never existed.

Section 13 of the Act of March 3, 1891 (1 Sup. Rev. St., p. 951), provides:

"That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens; or when such foreign state or nation is a party to an international agreement which provides for reci-

procity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States, by proclamation made from time to time as the purposes of this act may require."

It would seem hardly necessary to go further in this case than the reading of this statute. Bong was not the proprietor, Hernandez having never sold or assigned him the painting. The assignment of the copyright or a right to copyright was ineffectual.

See opinion of Judge Townsend in case of Werckmeister *vs.* Springer Lithographing Co., 63 Fed. Rep., 808, at page 811.

"Did the purchaser in this case become the 'proprietor' within the meaning of the statute? I think not. I think by 'proprietor' in this statute is intended the person who not only obtains the right to physical possession of the painting, but the common law rights of the publication or preventing publication which belong to the author. I do not think that these common law rights absolutely and of necessity accompany the title to the canvas and coloring matter which constitute the painting."

See also Werckmeister *vs.* American Lithographic Co., 142 Fed. Rep., 827, at page 831:

"The statute does not say what the 'assigns' shall be the assignee of. It is the 'assigns of any such person'—that is, of an author; but what the thing assigned shall be the statute does not state. But when the person has two kinds of property which, in their nature, are inherently distinct, and which the law treats, for certain purposes, as being distinct, presumably he has a right to assign either of such kinds of property separately from the other; and I do not find anything in this statute which neces-

sarily confines the meaning of the word 'assigns' to a person to whom a thing copyrighted has been transferred, excluding a person to whom the copyright has been transferred. It is said that the expression that the author or his assigns shall have the sole liberty, among other things, of 'completing, executing and finishing the same,' *indicates that the term 'assigns' must be confined to the thing copyrighted.*"

As is shown by these cases, and all other cases under the Copyright Act, the word "proprietor" in this section refers to the owner. The case of Mifflin against White Co., 190 U. S, 260, 262, cited in the plaintiff's brief, refers to the word as used in another section and under the Act of February, 1831.

Bong is the assignee or licensee simply of whatever rights Hernandez had to obtain a copyright in this country; this is conclusively shown by the cases above cited and by all other cases on this point. It is a very close question whether a person not the owner may obtain a copyright. That question will ultimately have to be decided by the Supreme Court. But it seems futile to argue that Hernandez could in this instance assign something that he never owned and which was non-existent. Hernandez also attempted to assign a right which the statutes of the United States affirm in express terms that he shall not enjoy. *The statute provides that the whole copyright laws and rights thereunder shall only apply to a citizen or subject of a foreign state or nation when that state or nation permits to citizens of the United States the benefit of copyright on substantially the same basis as its own citizens.* The plain purpose of this section is to procure to the citizens of this country copyright rights in foreign countries and to compel foreign countries to grant such rights to citizens of the United States and in the case of their failure to do so, to deprive citizens of such countries from enjoy-

ing such rights here. This was put very clearly by Judge Hough in his charge to the jury (fols. 50–52):

"By the opening statement of counsel for the plaintiff, it is shown that he intends to offer no evidence to substantiate the assertion of the complaint that the artist who painted the original picture, the reproduction of which is the origin of this controversy, is a subject of the King of Spain. He asserts his intention of standing upon the proposition that the citizenship of the artist is of no moment, *and the case must therefore be decided as if Senor Hernandez were a citizen of a country not within the terms of the President's proclamation made pursuant to the International Copyright Act. Is that fair, Mr. Kohler?*

Mr. Kohler: It is absolutely fair, your Honor."

The complaint alleged (subdivision III, p 3 of the Record, fol. 5), that by virtue of the citizenship of Hernandez, *in Spain*, he assigned his rights to the copyright to Bong. This was controverted by the answer (fol. 10). The burden was on the plaintiff to sustain his pleading and his claim by proof. That he declined (fols 16, 17).

The Court: "It may be deemed for the purpose of argument that the plaintiff in this case, Richard Bong, is a subject of the Empire of Germany, and Germany is a country within the President's proclamation under the copyright statute.

It may well be within the power of Congress to grant to all aliens the privilege of copyright; but the present statutes do not in terms give that right to aliens other than those who are citizens or subjects of countries extending similar bounty to Americans.

The claim, therefore, that the citizen of a country not within our copyright acts can assign the right of reproduction to one who can obtain that privilege must be tested by the general rules of law as applied to the interpretation of copyright acts in coun-

tries governed by systems of law of English origin.

If Senor Hernandez could not himself obtain copyright in the United States—and I think it clear that he could not unless he were a citizen of a country within the President's proclamation—and could yet directly or indirectly (short of selling or giving away his picture before publication) confer upon another what he had not himself, then I think the present International Copyright Act an idle form; inasmuch as any country may refuse to American citizens all right of protection in literary or artistic productions, while their own citizens can always, by a colorable assignment to the subject of a more generous sovereign, obtain the protection of American law. I think this unfair and within neither the letter nor the spirit of the present statute."

A copyright, the exclusive privilege to multiply copies after publication, is a right granted to an individual by the State in the nature of a special privilege or franchise; if it is not granted by the State it does not exist. See subsequent discussion in this brief. Under what statute was any right granted to Hernandez which he could assign? The theory of the cases which hold that an assignee of the copyright rights may obtain a copyright in this country are based on the theory that the author or owner owns two distinct species of property, and that he can assign either without assigning the other.

Everything must have its birth and beginning, and where in this case did the right to a copyright originate? If Bong had been the proprietor of the painting, he could not have obtained a copyright in this country. That precise question was decided in the case of Yuengling *vs.* Schile, 12 Fed. Rep. 97, as was stated by the Court in that case on page 102:

"The plaintiff claims that the Act of July 8, 1870 (16 St. at Large, §86; Rev. St. 4952), authorizes a citizen or resident of this country, if he be 'pro-

prietor' of any book, map, print, chromo, &c., to obtain a copyright therefor, although the author, inventor, or designer, is an alien. The Act of 1870, for the first time, uses the word 'proprietor' in connection with the words 'author, inventor or designer,' as one of the persons to whom a copyright may be granted, although ever since the Act of 1790 the proprietor might obtain a copyright if he were a lawful representive of the exclusive rights of a native or resident author. Thus, though the connection in which the 'proprietor' is used in the Act of 1870 is new, the use of the word itself in relation to the copyrights is as old as the laws of copyright. 1 St. at Large, p. 125, §§ 2, 3, 4, 6; 2 St. at Large, p. 171, §§ 1, 3; 4 St. at Large, p. 437, § 3; 11 St. at Large, p. 139, § 1; 13 St. at Large, p. 540, § 2; 8 Geo. II, c. 13, § 1; 17 Geo. III, c. 57.

The literal reading of the section of the Act of 1870, now embodied in Section 4952 of the Revised Statutes, does not require that both the 'author' and 'proprietor' shall be citizens or residents of the United States. It provides that 'any citizen of the United States or resident therein who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of fine arts, and the executors, administrators or assigns of any such person' may obtain a copyright; and Section 103 of the Act of 1870, embodied in Section 4971 of the Revised Statutes, provides that 'nothing therein shall be construed to prohibit the printing, publishing, importation or sale of any book, map, chart, dramatic or musical composition, print, cut, engraving or photograph, written, composed, or made by any person not a citizen of the United States, nor resident thereof. By virtue of the latter section an exclusive copyright in the work of any foreign author or artist in the subjects mentioned in that section is prohibited; but this section does not embrace

the words 'painting, drawing, chromo, statue, statuary and models,' which were introduced into the Copyright Law for the first time in the Act of 1870; and on this ground it is urged by the complainant that the 'proprietor' may obtain a copyright on the last-mentioned subjects, though the artist or author is an alien, because these are not prohibited by Section 4971.

There are three objections to the plaintiff's contention in this respect: first, that it involves a reversal of the policy of the Government from its foundation to protect American artists and authors only; second, that the word 'proprietor,' as used in the copyright laws, in itself means the representative of an artist or author who might himself obtain a copyright; and, third, that chromos are in reality embraced under the description of a 'print' in the restrictive section, 4971.

It can not be doubted that the purpose of the copyright laws from the foundation of the government has been to encourage native talent, and to protect American authors and artists only (Drone, Copyright, 231, 257), as the English acts were designed 'to protect only those works which were designed, engraved, etched, or worked in Great Britain' (Page *v.* Townsend, 5 Sim., 395, 404)."

And then on page 105:

"From the Act of 1790 down to 1870 there could be no 'proprietor' in sense of the Copyright Law, except the owner of the work of a citizen or resident author, including a transfer of said resident's right of copyright.

POINT II.

The right to copyright is indivisible.

Here Hernandez specifically reserves the right of certain kinds of reproduction.

The assignment to Bong provided (fol. 46):

"P. S.—It is well understood that the right of photography and reproduction by all photographic monochrome processes are not herein included."

Thus a remarkable spectacle is presented of Hernandez, a Peruvian, who our statutes say shall not enjoy the protection of our copyright laws, attempting to authorize Bong, a German, to take out a copyright in Bong's name, and Hernandez at the same time reserving to himself certain rights of reproduction under the copyright. The complaint should have been dismissed on this ground alone.

POINT III.

The Librarian of Congress has always construed our statute as denying to citizens of Peru copyright protection, and that the assignee of one who could not obtain a copyright could not obtain one; and it is respectfully submitted that this construction of the statute is most reasonable, well established, and entitled to great weight as a departmental construction.

U. S. *v.* Graham, 110 U. S., 219.
U. S. *v.* Tanner, 117 U. S., 661.

There is no doubt as to the construction put upon the statute by the Librarian of Congress, and it is respectfully submitted that this Court may take judicial notice of said construction.

POINT IV.

This is an action for a penalty and under a statute highly penal in its nature. And the statute should be strictly construed against the plaintiff.

The plaintiff seeks a forfeiture against the defendant of the sum of ten thousand dollars ($10,000). As was stated by Judge Hough (see fol. 53):

"I am the more willing to arrive at this conclusion because it has been held in many cases, in England, especially, and in actions that were brought under copyright acts, that if there be any reasonable interpretation of the act which will avoid a penalty, or if there be two reasonable interpretations of the act and one of them will avoid the the penalty, then the more lenient one shall be adopted."

See Boles *vs.* Outing Company, 175 U. S., 262.

POINT V.

In answer to the first point on the brief of the plaintiff in error, the defendant calls attention again to the fact that the artist, Hernandez, when he assigned to the plaintiff Bong, had no assignable interest and that consequently the assignee Bong took nothing by the assignment. This position stands out clearly in

Werckmeister *vs.* Pierce & Bushnell Mfg. Co., 63 Fed. Rep., 445–449:

"The English copyright statute (25 and 26 Vict. c. 68) which created the law authorizing copyrighting of patents (Fishburn *vs.* Hollingshead (1891) 2 ch. 371–379), and which is still in force, contains regulations touching this matter enabling the artist when disposing of his painting to retain or dispose of the right to reproduce it, but nothing of this nature is found in our statutes, and the question arises therefore how far their general terms are intended to vary from the practice of the common law referred to, *that is, the right to a copyright in the artist so long as he retains the painting.* Is there or is there not enough in that to forego the presumption that the statutes do not change the common law except so far as the intention to do so is apparent? In the absence of something showing an intention to vary the common law rule, it must be presumed to stand. We do not mean by this that at common law the owner of a painting might not empower some other person than himself to elect as to the publication, or that he might not dispose of the painting reserving to himself the right of such election; but we mean to say that, inasmuch as at the common law, this right is presumed in the pro-

prietor of the painting, it requires something more than the general expressions in the statute to satisfy the Court of an intention to vest the privilege of *securing the copyright in any other person than the one in whom it presumably exists.* Moreover, the word 'assigns,' on which the plaintiff relies, is ordinarily construed as only indicating the nature of the subject, *and its ordinary effect is only to the extent of declaring that whatever is obtained is of an assignable character.*"

The question has not received consideration in reference to aliens, but in other instances, the courts have not hesitated to declare that, in order to entitle an assignee to the benefit of the statute of copyright, the assignment must have been made by one himself entitled to copyright.

Koppel *vs.* Downing, 11 App. Cases (D. C.), 93;
Banks *vs.* Manchester, 128 U. S., 244;
Yuengling *vs.* Schile, 12 Fed. Rep., 97, 103.

It is claimed by the plaintiff in error, page 26 of his brief, that Hernandez assigned to Bong some common law right of copyright that survived the transfer of the painting.

When Hernandez assigned to Bong he had no common law rights of copyright for he had parted with the ownership of the painting and no application for copyright had been made by him or by the proprietor of the painting.

It is not clear how far the courts have abandoned the position that there is no common law of copyright in this country, and that whatever rights are possessed by the proprietor must be derived from some grant thereof in some act of Congress either *nominatim* or by satisfactory implication. But the

declaration of the status of the matter is very emphatic in

Wheaton *vs.* Peters, 8 Pet., 591.
Stevens *vs.* Gladding, 17 How., 447, 454.
American Tobacco Co. *vs.* Werckmeister, 207 U. S., 284, 291.
Holmes *vs.* Hurst, 174 U. S., 82, 85.
Banks *vs.* Manchester, 128 U. S., 244, 252.
Thompson *vs.* Hubbard, 131 U. S., 123, 151.

The English Courts, The House of Lords, declared that a similar result followed from the enactment of the statute of Ann.

Donaldson *vs.* Becket, 4 Burr. 2408.

In distinguishing American Tobacco Co. *vs.* Werckmeister, 207 U. S., 284, 296-9, it appears that Sadler himself had the right to a copyright and therefore may have been deemed to have transferred the right to his assignee, *but that case does not sustain the claim that one who could not himself obtain a copyright and had no common law rights could transfer anything to an assignee.* It appears also in Werkmeister *vs.* Pierce & Bushnell Mfg. Co., 142 Fed. Rep., 827, that Naujok, the artist, and Werckmeister were both Germans.

It does not aid in the interpretation of our statute to recite the aims of a convention to which this country was not a party (see pp. 12-18, brief of plaintiff in error). The exposition of the purposes and proceedings under those "conferences" would more properly be a subject of consideration by the Legislature.

POINT VI.

In reply to the Point II of the brief of the plaintiff in error, it is evident that German publishers and artists were put on their guard rather than misled by the public protest in the Reichstag over the alleged narrowness of the American policy (p. 24 of plaintiff's brief). If we are unfair in our statutes, the plaintiff in error should address our Congress. This case hardly falls within the scope of an exhortation to the courts to enlarge the law for the benefit of the plaintiff in error. He asks to be supported in deriving profit from a copyright which was obtained by a misstatement of the nationality of the artist and assignor of the plaintiff. It would not be uncharitable to assume that the plaintiff knew of the weakness of his title to the copyright, and sought to avoid the inevitable question that would arise if he candidly announced the nationality of Hernandez. The plaintiff's position does not appeal to the Court to relieve him of the effect of his inaccuracy.

POINT VII.

In reply to point III of the brief of the plaintiff in error, the defendant answers that the opinion of the learned Judge at the Circuit Court does not materially rest on the penal nature of the copyright statute. Whether the statute is penal or not, it clearly appears that the plaintiff had no valid right to a copyright. A liberal construction of the copyright law would not overrule the plain intention of the Legislature as expressed by the wording of the statute. The remark of the Judge was casual, rather than a statement of a fundamental ground of the direction to the jury.

The comment in the plaintiff's brief concerning the effect on the jury of the remark of the Court that a penalty " is a very noxious thing " (p. 36 of brief), is of little moment since the jury on this trial had no determinative part in the result and the expression on that incidental point would not become the law of the case, so as to affect future juries. Yet, Mr. Justice Day, of this Court, in an opinion filed December 16, 1907, said: " The statute does not provide a proceeding *in rem* * * * the act is levied against *the person*. This section of the statute is penal and there should be special care to work no extension of its provisions by construction."

Werckmeister *vs.* American Tobacco Company, 207 U. S., 375, 381.

It should be observed that the effort of the plaintiff is to extend the right to secure the penalties in favor of one not entitled to copyright.

POINT VIII.

In Point IV of the plaintiff's brief, the objection to the expression "*colorable assignments*" is rather verbal than substantial. The intention evidently was to point out an easy method of avoiding the provisions of our copyright law by citizens of nations that would not grant the same privileges to our citizens. Such practices are severally condemned in Yuengling vs. Schile, 12 Fed. Rep., 97, 104.

The references to the real property law (p. 38 of brief), as applicable to the claim that one may convey a better title to his grantee than he himself possesses reveals the fact that the weakness of titles in real property is overcome by statutory provisions addressed to that particular point, for instance, New York Real Property Law, Section 294, also New York Statutes, 1897, Ch. 593, and it only emphasizes the propriety of seeking relief through Congress.

POINT IX.

In the plaintiff's brief, Point V, he declares that the direction cannot be sustained apart from the question of the nationality of the artist Hernandez. But the alienage and the nationality of the artist have always been the main reliance of the defendant. It was recognized by the plaintiff as the weak link in the chain of his title, even when he applied for the copyright. There is no necessity here to argue other points of objection further than they have already received consideration in the preceding parts of this brief.

POINT X.

The argument of Point VI of the plaintiff's brief may fairly be paraphrased as follows:

There is a Berne International Copyright Union It provides that countries not parties to the Union shall be permitted to accede thereto *upon their request.* The accession shall be *notified in writing* to the Swiss and the latter will notify the other members of the Union. *Joining implies adhesion to all the clauses of the Convention.* The United States, if it joins that Union, must abandon a condition to which it adheres, viz.: that application for copyright must be made by depositing *books printed from type set in this country.* There is also a Mon-

tevideo Copyright Union. Every State that approves it must *notify* the Argentine Republic and Uruguay and they will notify the other members of the Union. Peru joined this Union in 1888. (It should be observed that no notice was ever given by the United States to either Union.)

The argument continues: Both those Unions are referred to in Simond's report to Congress, which accompanied the Act of 1891. The language of that bill was used with reference to including them *ipso facto*. (But those Unions are not referred to in the Act of 1891.) The President could not of his own will proclaim this country a member of those Unions, legislation was necessary to signify our intention to join. Moreover, if this country became a member of those Unions, it must give adhesion to all the clauses of the Conventions and that necessitated an abandonment of the clause in our copyright law to the effect that the copies of books deposited with the Congressional Librarian, by an alien applicant for copyright, should be printed from type set in this country. Those conventions did not recognize that limitation. In consequence of that situation, it was claimed that the United States was not even free, "at its pleasure," to join either of the Unions.

This conclusion, says the plaintiff's brief, is erroneous, for the statute of March 3, 1891, does not provide that the United States must first join the Union in order to entitle the citizens of the countries included in those Unions to the privileges of copyright in this country, but it was merely necessary for this country *to be able* to join those Unions. That makes the statutory enactment of those countries the criterion and fastens on us without proclamation or notification on our part the necessity of recognizing the right of copyright in their citizens whether we unite or not. That would be somewhat anomalous.

The argument proceeds that various efforts were made by successive Presidents to have a law passed

that would make the United States a member of each of those Unions. At last on March 3, 1891, a law was passed, of which Section 13 reads as follows:

"That this Act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens; or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States, by proclamation made from time to time as the purposes of this Act may require."

Now, says the brief, the President made no proclamation, to be sure, but that Act is self-executing, for the Legislature must have had in mind the Berne and Montevideo Unions (although it failed to mention or refer to them except as such reference may be inferred from the section of the Act above set forth). The inevitable conclusion is that the United States had the opportunity to join but did not embrace it and moreover could not embrace it. Yet because Peru is a member of the Montevideo Union which the United States *could* have joined, therefore Peru is entitled to take advantage of our copyright law.

There is no foundation of proof in the Record to show the contents of the Conventions of the Berne and Montevideo Copyright Unions, nor of many of the salient facts enumerated in Plaintiff's Point VI. Those Conventions are in the nature of foreign laws of which the Court does not take judicial notice. Much of the other alleged facts are imported. Yet, if they were legitimately in the Record, they would afford no support to the appeal.

POINT XI.

The statement of facts in Point VII is not quite correct when it alleges that the direction to the jury was based on the opening. The direction was based not alone on what the plaintiff's counsel said, but on certain written documents submitted to the Court by consent of counsel on both sides, see page 9 of the Record. The whole of the plaintiff's case was substantially submitted to the presiding justice so far as the title to the copyright was concerned.

It does not make the position of the plaintiff better to claim that the ownership of the picture and the copyright were both in Germans, page 49 of Brief, while the fact remains undisputed that the title of the plaintiff was derived by assignment from Hernandez, who was a native of Peru.

The recital in Point VII of the alleged contents of papers said to be on file is so unfair and irregular that the defendant refrains from further discussion of facts not before the Court, and simply protests against the practice.

POINT XII.

The judgment should be affirmed.

Respectfully submitted,

GEORGE RYALL,
Of Counsel for the Defendant in Error.

BONG, PLAINTIFF IN ERROR, *v.* ALFRED S. CAMPBELL ART COMPANY.

ERROR TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

No. 150. Argued April 15, 1909.—Decided May 24, 1909.

Under § 4952, Rev. Stat., as amended by the act of March 3, 1891, c. 565, 26 Stat. 1106, the assignee of an author of a painting is not entitled to copyright unless the author is a citizen of a country to the citizens of which reciprocal copyright privileges have actually been extended by proclamation of the President in conformity with § 13 of the act of March 3, 1891. The fact that the assignee is a citizen of such a country does not entitle him to copyright.

An assignee within the meaning of the copyright statute is one who receives a transfer not necessarily of the painting but of the right to multiply copies thereof, and such right depends not only upon the statute but is derived also from the painter, who must have the right to copyright in order to assign it.

A citizen of a country not in copyright relations with the United States under § 13 of the act of 1891 is not entitled to avail of the copyright because his country is a member of the Montevideo Union.

The provision in § 13 of the act of 1891, providing that the President on determining certain conditions extend the privileges of copyright to citizens of countries which are parties to a copyright union to which the United States may become a party is not directory and confers no rights independent of the President's proclamation.

Where a statute contemplates reciprocity of rights the President is the best fitted officer to determine whether the conditions on which reciprocity depends exist; and this court approves the construction given by the State Department and the Librarian of Congress to the copyright statutes as denying copyright protection to Peru, no proclamation extending copyright to the citizens of that country having ever been made by the President.

Where the head of a department of the Government is authorized to make regulations in aid of a law, he cannot make regulations which defeat it. *Williamson* v. *United States*, 207 U. S. 425.

The practice of disposing of cases on the opening of counsel is generally an unsafe method of procedure; the case should be developed by the evidence. *Hoffman House* v. *Foote*, 172 N. Y. 348, approved.

155 Fed. Rep. 116, affirmed.

THE facts, which involve the construction of the international and reciprocity provisions of the Copyright Act, are stated in the opinion.

Mr. Max J. Kohler for plaintiff in error:

The plain and unambiguous language of the act of March 3, 1891, confers copyright where the person applying for the same as proprietor or assign of the author or proprietor is a subject of a country with which we have copyright relations, whether the author be a subject of one of those countries or not.

Section 13 of the act of 1891 is satisfied if the "proprietor" or "assign" taking out the copyright is a citizen of a country with which we have copyright relations.

Section 4952, as amended in 1891, authorizes either the "author" or "proprietor" of a work or his "assigns," to copyright the same. The only limitation is in § 13, which provides that this shall only "apply to a citizen or a subject of a foreign state" as to which the President has issued his proclamation. There is no suggestion of any limitation to citizenship of country of production, and the only statute that had contained any such limitation, § 4971, was expressly repealed. The limiting of statutory copyright to work of Americans (*Yuengling* v. *Schile*, 12 Fed. Rep. 97) was expressly abandoned by Congress. *Werckmeister* v. *Pierce*, 63 Fed. Rep. 445; *Merriam Co.* v. *Dictionary Co.*, 146 Fed. Rep. 354; aff'd 208 U. S. 260; *Oliver Ditson Co.* v. *Littleton*, 62 Fed. Rep. 597.

The only case which seems to have considered the branch of the statute here involved is *Britannica Co.* v. *Werner Co.*, 135 Fed. Rep. 841, where Judge Lanning, in a case involving a book, paraphrased the statute as here contended for.

Since § 4952 was first enacted in the revision of July 8, 1870, the "proprietor" or "assign" of the author, as well as the author himself, has been permitted to take out a copyright in his own name. The act of 1870, expressly interpolated the word "proprietor" when paintings were first made copyrightable. 16 Stat. 212; Solberg on Copyright, 46; *Am. Tobacco*

Co. v. *Werckmeister*, 207 U. S. 284, 296, 299; affi'g 146 Fed. Rep. 375; *Werckmeister* v. *Pierce*, 63 Fed. Rep. 445, 449; *Werckmeister* v. *Springer Co.*, 63 Fed. Rep. 808; *Werckmeister* v. *Am. Lith. Co.*, 142 Fed. Rep. 827,830; aff'd 146 Fed. Rep. 377; *Mifflin* v. *White Co.*, 190 U. S. 260; *Lawrence* v. *Dana*, 4 Cliff. 1; *Parton* v. *Prang*, 3 Cliff. 537; *Callaghan* v. *Myers*, 128 U. S. 617, 658.

The copyright law contains at present no limitation as to country of production of the work and § 13 has nothing to apply to except the provisions of § 4952, amended at the same time this statute was adopted, and establishing the rights of persons to take out copyrights, either as "author," "proprietor" or "assign," and it seems obvious that the law requires merely that the person taking out the copyright must be a citizen of such country, irrespective of the nationality of the author.

The experience and legislation of the rest of the civilized world, antedating the framing of this act, led to the adoption by them of a policy protecting works published in a country, as well as those by native authors or artists, and it was undoubtedly the purpose of Congress to adopt such policy.

Public policy does not require a strict construction of our copyright protection to citizens or "proclaimed" authors. In fact it is the consensus of opinion abroad that it is unwise to pursue a retaliatory policy in copyright matters and certainly the United States cannot afford to welcome such policy. The British copyright commission of 1878 advised against such course with particular reference to the United States.

Something was said on the trial as to an alleged construction by the Librarian of Congress of our copyright laws against recognizing rights based upon assignments from authors who are citizens of countries not covered by proclamations. The fact of such construction is challenged; to counsel's own knowledge a copyright was granted after consideration of this question in 1901, some years before the copyright proclamation as to China, for a work by a Chinese author, the manuscript of

which had been assigned to an American, A. S. Taylor. The copyright bureau in fact has stated that the question is a doubtful one requiring determination. (Report on copyright legislation by the Register of Copyrights for the year ending June 30, 1903, pp. 10, 11). If there be any such construction it is obviously wrong and is not uniform, long established nor reasonable, so as to be entitled to any weight as an alleged departmental construction. *United States* v. *Graham*, 110 U. S. 219; *United States* v. *Tanner*, 147 U. S. 661. Nor, as he himself conceded, is the Librarian of Congress given any discretionary power, but he is a mere ministerial officer (Report cited, *supra*, pp. 31, 32).

Even before the international copyright law amendment of 1891, the proprietor of a painting who was himself a citizen or resident of the United States, could have secured a copyright, even though the artist may have been a non-resident alien, but the rule was different as to books and other articles enumerated in § 4971, because of the express provisions of that section.

But defendant argued below, chiefly on the assumption that Mr. Hernandez's assignment to Mr. Bong passed nothing, because Mr. Hernandez himself could not have secured a copyright under our statutes, under the act of March 3, 1891, because a Peruvian, and such is the reasoning of the Circuit Court of Appeals.

In the light of the laws of foreign countries and the Berne convention, which were carefully studied by the lawmakers, it seems obvious that the removal of an alien's lack of capacity to copyright was cured by assignment or descent from the alien; disability by assignment was expressly intended by Congress in the international copyright act, just as had been done in terms in foreign countries, where the limitation to native "authors" had been abolished.

The language of our copyright law is unmistakable and unambiguous in making right to copyright turn simply on the citizenship of the person taking out the copyright.

Mr. Bong, before he sought his Federal copyright, and published the painting under those limitations in photogravure reproductions, could have enjoined defendant's infringement as a violation of his common-law copyright rights, and in the Federal court, because of jurisdiction based on his alienage. The copyright act in exchange for publication, gave him a statutory copyright for a limited period, upon compliance with its terms.

The common-law copyright rights, before publication, of the painter or owner of a painting or other copyrightable objects, are of course well established. *Werckmeister* v. *Am. Lith. Co.*, 134 Fed. Rep. 321; aff'd 207 U. S. 284; *Parton* v. *Prang*, 3 Cliff. 537; *Werckmeister* v. *Am. Lith. Co.*, 142 Fed. Rep. 827; aff'd 146 Fed. Rep. 377; *Turner* v. *Robinson*, 10 Ir. Ch. Rep. 121, 510; *Oertel* v. *Wood*, 40 How. Pr. 10; *Prince Albert* v. *Strange*, 2 De Gex & Smale, 652; *Press Pub. Co.* v. *Monroe*, 73 Fed. Rep. 196; appeal dismissed, 164 U. S. 105; *Palmer* v. *De Witt*, 47 N. Y. 532; *Thomas* v. *Lennon*, 14 Fed. Rep. 849; *Iolanthe Case*, 15 Fed. Rep. 439; *Mikado Case*, 25 Fed. Rep. 183; *Globe Co.* v. *Walker*, 210 U. S. 356.

See also *Mansell* v. *Valley Printing Co.* (1908), 1 Ch. 198; aff'd (1908) 2 Ch. 441, in which the English court has held that as to paintings, the common-law copyright subsisted until publication, unlike printed books.

This rule of law as to common-law copyright is not limited in any way under the American authorities, to productions by American authors or painters. 7 Am. & Eng. Ency. of Law, 519; *Palmer* v. *De Witt*, 47 N. Y. 532; *Crowe* v. *Aiken*, 2 Biss. 208; *Keene* v. *Wheatly*, 14 Fed. Cas. 7,644; *Thomas* v. *Lennon*, 14 Fed. Rep. 849; *Tompkins* v. *Halleck*, 133 Massachusetts, 32; *French* v. *Maguire*, 55 How. Pr. 471; *Shook* v. *Daly*, 49 How. Pr. 366.

The convention with Germany referred to in the President's proclamation, specified in the complaint, requires a liberal construction in favor of the German assignee's rights.

The court's argument below that because colorable assign-

ments might be resorted to, the statute should be construed to deny copyright to works produced by citizens of countries outside the President's copyright proclamation, is untenable. *Carte* v. *Evans*, 27 Fed. Rep. 861; *Black* v. *Allen Co.*, 42 Fed. Rep. 618.

The direction of a verdict was not based, nor is it sustainable, on the theory that plaintiff, apart from the alienage question, had no copyrightable interest in the painting.

A transfer of common-law copyright in a painting entitles the transferee to take out a copyright, though he does not own the physical painting. This question was still doubtful when this case was tried below. *Am. Tobacco Co.* v. *Werckmeister*, 207 U. S. 284, 296–299; aff'g 146 Fed. Rep. 375.

An assignee of the American copyright rights is entitled in his own behalf to copyright the painting. Cases cited, *supra*, and *Goldmark* v. *Kreling*, 35 Fed. Rep. 651; *Merriam Co.* v. *United Dictionary Co.*, 146 Fed. Rep. 354; *Werckmeister* v. *Springer Co.*, 63 Fed. Rep. 808; *Palmer* v. *De Witt*, 47 N. Y. 541.

Such is the usual course with respect to transfer of American rights. Even if the copyright were held in part by him for the benefit of persons other than plaintiff, he would be entitled to take out the copyright in his own name. *Press Pub. Co.* v. *Folk*, 59 Fed. Rep. 324; *Lawrence* v. *Dana*, 15 Fed. Cas. 8,136; *Wooster* v. *Crane* 147 Fed. Rep. 515; *Goldmark* v. *Kreling*, 35 Fed. Rep. 661; 7 Am. & Eng. Ency. of Law, 2d ed., 545; *Mifflin* v. *White Co.*, 190 U. S. 260; *Ford* v. *Blaney Co.*, 148 Fed. Rep. 642; *Harper* v. *Donohue & Co.*, 144 Fed. Rep. 491, 494; *Osgood* v. *Felsenheld* (Imperial Court of Germany).

The construction placed by the State Department on § 13 of the act of March 3, 1891, is erroneous, and even Hernandez, as a subject of Peru, which country belongs to the Montevideo International Copyright Union, was entitled to a statutory copyright in his own right. *Morrill* v. *Jones*, 106 U. S. 466; *Campbell* v. *United States*, 107 U. S. 407, 410; *United States* v. *Dominci*, 78 Fed. Rep. 334; *Buttfield* v. *Stranahan*, 192 U. S. 470, 496; *Williamson* v. *United States*, 207 U. S. 425, 461.

Mr. George Ryall for defendant in error:

Hernandez, being a citizen and subject of Peru, could not have obtained a copyright in this country, and most assuredly he could not assign a right which never existed. *Werckmeister* v. *Springer Lith. Co.*, 63 Fed. Rep. 808; *Werckmeister* v. *Am. Lith. Co.*, 142 Fed. Rep. 827.

The Librarian of Congress has always construed our statute as denying to citizens of Peru copyright protection, and that the assignee of one who could not obtain a copyright could not obtain one; and it is respectfully submitted that this construction of the statute is most reasonable, well established, and entitled to great weight as a departmental construction. *United States* v. *Graham*, 110 U. S. 219; *United States* v. *Tanner*, 117 U. S. 661.

In answer to the first point on the brief of the plaintiff in error, the defendant calls attention again to the fact that the artist, Hernandez, when he assigned to the plaintiff Bong, had no assignable interest and that consequently the assignee Bong took nothing by the assignment. This position stands out clearly in *Werckmeister* v. *Pierce & Bushnell*, 63 Fed. Rep. 445–449.

Mr. Justice McKenna delivered the opinion of the court.

This is an action under the copyright statutes to recover penalties and forfeitures for the infringement of a copyright of a painting.

The complaint shows the following facts: Plaintiff in error (as he was plaintiff in the trial court we shall refer to him hereafter as plaintiff, and to defendant in error as defendant) was a citizen and subject of the German Empire and resident of the city of Berlin, that nation being one which permits to citizens of the United States the benefit of copyright on substantially the same basis as its own citizens. It is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States may at its pleasure become a party, the existence of

which condition has been determined by the President of the United States by proclamation duly made. April 15, 1892, 27 Stat. 1021. The defendant is a New Jersey corporation doing business in New York under the laws of the latter State.

In 1899 one Daniel Hernandez painted and designed a painting called "Dolce far niente," he then being a citizen and subject of Spain, which nation permits the benefit of copyright to citizens of the United States on substantially the same basis as its own citizens, as has been determined by the proclamation of the President of the United States. July 10, 1895, 29 Stat. 871. Prior to November 8, 1902, plaintiff became the sole proprietor of said painting by due assignment pursuant to law. About said date plaintiff applied for a copyright, in conformity with the laws of the United States respecting copyrights, before the publication of the painting or any copy thereof. Plaintiff inscribed, and has kept inscribed, upon a visible portion of the painting the words "Copyright by Rich Bong," and also upon every copy thereof. By reason of the premises, it is alleged, plaintiff became and was entitled for the term of twenty-eight years to the sole liberty of printing, reprinting, publishing and vending the painting. A violation of the copyright by defendant is alleged by printing, exposing for sale and selling copies of the painting under the name of "Sunbeam," by Hernandez, and that defendant has in its possession over 1,000 copies. By reason of the premises, it is alleged, and under § 4965 of the Revised Statutes of the United States, as amended by the act of March 2, 1891, defendant has forfeited the plates on which the painting is copied and every sheet thereof copied or printed, and $10 for every copy of the same in its possession and by it sold or exposed for sale, not more, however, than $10,000, whereof one-half shall go to plaintiff and the other half to the United States. Judgment of forfeiture is prayed.

Defendant answered, admitting that it was a corporation as alleged, and was doing business in New York. It denied, either absolutely or upon information and belief, all other allegations.

The court directed a verdict for the defendant, counsel for the plaintiff having stated in his opening, as it is admitted, that he would offer no evidence to establish the citizenship of Hernandez, and would not controvert the statement made by the defense that he was a citizen of Peru (it was alleged in the complaint that he was a citizen of Spain), as to which country the President had issued no copyright proclamation. It is also admitted that plaintiff never owned the "physical painting." There was introduced in evidence a conveyance of the right to enter the painting for copyright protection in America and the exclusive right of reproduction in colors and of engraving, etching, lithography, in black and in colors. The right of photography and reproduction by all photographic monochrome processes was reserved.

The ruling of the District Court, and that of the Court of Appeals sustaining it, were based on the ground that Hernandez, being a citizen of Peru and not having the right of copyright in the United States, could convey no right to plaintiff. Plaintiff attacks this ruling and contends that the act of March 3, 1891, "confers copyright where the person applying for the same as proprietor or assign of the author or proprietor is a subject of a country with which we have copyright relations, whether the author be a subject of one of those countries or not."

Whatever strength there is in the contention must turn upon the words of the statute conferring the copyright. Section 4952 of the Revised Statutes, as amended by the act of March 3, 1891 (c. 565, 26 Stat. 1106, 1 Sup. Rev. St. 951), reads as follows:

"The author, inventor, designer or proprietor of any book, map, chart, . . . painting . . . and the executors, administrators and assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending the same," etc.

Other sections prescribe the proceedings to be taken to secure copyright, and § 13 provides as follows (26 Stat. 1110):

"That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens, or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may at its pleasure become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States by proclamation made, from time to time, as the purposes of this act may require." 1 Sup. Rev. St. p. 954.

Plaintiff urges that he is "the 'assign' of the author and proprietor of the painting . . . and being himself a 'citizen or subject of a foreign nation' with which we have copyright relations," the condition of the statute is satisfied, and his copyright is valid, though Hernandez was not such citizen or subject. In other words, though the author of a painting has not the right to copyright, his assignee has if he is a citizen or subject of a foreign state with which we have copyright relations, these being, it is contended, the conditions expressed in § 13. Counsel's argument in support of this contention is able, but we are saved from a detailed consideration of it by the decision of this court in *American Tobacco Company* v. *Werckmeister*, 207 U. S. 284. In that case we said that "the purpose of the copyright law is not so much the protection and control of the visible thing, as to secure a monopoly, having a limited time, of the right to publish the production, which is the result of the inventor's thought." In considering who was entitled to such right under the statute we defined the word "assigns," as used in the statute. We said: "It seems clear that the word 'assigns' in this section is not used as descriptive of the character of the estate which the 'author, inventor, designer or proprietor' may acquire under the statutes, for the 'assigns' of any such person, as well as the persons themselves, may, 'upon complying with the provisions

of this chapter, have the sole liberty of printing, publishing and vending the same.' This would seem to demonstrate the intention of Congress to vest in 'assigns,' before copyright, the same privilege of subsequently acquiring complete statutory copyright as the original author, inventor, dealer or proprietor," and there was an explicit definition of the right transferred as follows: "While it is true that the property in copyright in this country is the creature of the statute, the nature and character of the property grows out of the recognition of the separate ownership of the right of copying from that which inheres in the mere physical control of the thing itself, and the statute must be read in the light of the intention of Congress to protect these intangible rights as a reward of the inventive genius that has produced the work." In other words, an assignee within the meaning of the statute is one who receives a transfer, not necessarily of the painting but of the right to multiply copies of it. And such right does not depend alone upon the statute, as contended by plaintiff, but is a right derived from the painter and secured by the statute to the assignee of the painter's right. Of this the opinion leaves no doubt, for it is further said: "We think every consideration of the nature of the property and the things to be accomplished support the conclusion that this statute means to give to the assignees of the *original owner of the right to copyright an article* [italics ours], the right to take out the copyright secured by the statute independently of the ownership of the article itself." The same idea was repeated when the court came to consider whether the exhibition of the painting, which was the subject-matter of the case, in the Royal Gallery, constituted a general publication which deprived the painter, as the owner of the copyright, of the benefit of the statutory provision. It was said: "Considering this feature of the case, it is well to remember that the property of the author or painter in his intellectual creation is absolute until he voluntarily parts with the same." And the painter had the right of copyright, he being a subject of Great Britain, that country having copyright relations with

the United States. His assignee, Werckmeister, was also a citizen of a country having copyright relations with us. But it was the right of the painter which was made prominent in the case and determined its decision.

It was not an abstract right the court passed on, one that arose simply from ownership of the painting. It was the right given by the statute, and which, when transferred, constituted the person to whom it was transferred an assignee under the statute and of the rights which the statute conferred on the assignor. "It is the physical thing created, or the right of printing, publishing, copying, etc., which is within the statutory protection." It is this right of multiplication of copies that is asserted in the case at bar, and it is not necessary to consider what right plaintiff might have had under the common law "before he sought his Federal copyright and published the painting." See *White-Smith Music Co.* v. *Apollo Co.*, 209 U. S. 1.

It is next contended that Hernandez, as a subject of Peru, was entitled to a statutory copyright in his own right, because, as it is further contended, Peru belongs to the Montevideo International Union. This contention is based on the words of § 13, *supra*, which gives the right of copyright to a citizen or subject of a foreign state or nation when such state or nation "is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may, at its pleasure, become a party to such agreement." If this were all there were in the statute, the contention of the plaintiff might have some foundation. The statute, however, provides that the existence of such condition "shall be determined by the President of the United States by proclamation, made from time to time, as the purposes" of the "act may require." It is insisted, however, that this provision is directory and a right is conferred independent of the action of the President, his proclamation being only a convenient mode of proving the fact. We cannot concur in this view, nor do the cases cited by plain-

tiff sustain it. In *Morrill* v. *Jones*, 106 U. S. 466; *Campbell* v. *United States*, 107 U. S. 407; *Williamson* v. *United States*, 207 U. S. 425, this court decided that where the Secretary of the Treasury or Secretary of the Interior is authorized to make regulations in aid of the law, he cannot make regulations which defeat the law. In *Buttfield* v. *Stranahan*, 192 U. S. 470, a regulation of the Secretary of the Treasury fixed the primary standard of imported tea, and was sustained as an "executive duty to effectuate the legislative policy declared in the statute."

It is admitted that the decision of the State Department is adverse to the contention, and, it is asserted by defendant and not denied by plaintiff, that the Librarian of Congress has always construed the statutes as denying to citizens of Peru copyright protection. We think, besides, the statute is clear and makes the President's proclamation a condition of the right. And there was reason for it. The statute contemplated a reciprocity of rights, and what officer is better able to determine the conditions upon which they might depend than the President?

On the record, we think there was no error in directing a verdict on the opening statement of counsel. We agree, however, with plaintiff that it is better to let a case be developed by evidence. In *Hoffman House* v. *Foote*, 172 N. Y. 348, it was pertinently said: "The practice of disposing of cases upon the mere opening of counsel is generally a very unsafe method of deciding controversies where there is or was anything to decide."

Judgment affirmed.